TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

No. ~~236.~~ 1

FREDERICK BIRDSALL AND GEORGE F. LANGTRY, PLAINTIFFS IN ERROR,

vs.

C. C. COOLIDGE.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF NEVADA.

FILED SEPTEMBER 3, 1874.

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1 In the circuit court of the United States for the district of Nevada.

C. C. COOLIDGE, PLFF.,
v.
F. BIRDSALL AND GEORGE F. LANGTRY, defts.

C. C. Coolidge, who is a citizen of the State of California, and a resident of the city of San Francisco, in that State, plaintiff in this suit, complains of F. Birdsall, who is a citizen of said State, and a resident of the city of Sacramento therein, and George F. Langtry, who is a citizen of the State of Nevada and a resident of the town of Dayton, in that State, copartners under the firm and style of F. Birdsall & Co., defendants in this suit, and for cause of action shows—

1. That heretofore, and before the 8th day of December, A. D. 1863, and before and at the time of the making of the letters-patent hereinafter mentioned, one Zenas Wheeler, being a citizen of the United States, was the true, original, and first inventor or discoverer of a certain new and useful improvement in machines for amal-
2 gamating gold and silver, fully described in the letters-patent and schedule hereto attached, issued to him therefor as hereinafter mentioned, which was not known or used by others before his invention thereof, and was not at the time of his application for letters-patent therefor in public use or on sale with his consent or allowance as the inventor; and being so as aforesaid the inventor of such improvement, and being also a citizen of the United States, and having made due application therefor, and having fully, in all respects, complied with all the requisitions of the law in that behalf, he, the said Zenas Wheeler, did, on the 8th day of December, A. D. 1863, obtain certain letters-patent therefor, issued in due form of law to him in the name of the United States, under the seal of the Patent-Office of the United States, and signed by the Secretary of the Interior, and countersigned by the Commissioner of Patents, bearing date the day and year aforesaid, whereby there was granted unto him, the said Zenas Wheeler, his heirs, administrators, or assigns, for the term of seventeen years from the eighth day of December, A. D. 1863, the full and exclusive
3 right and liberty of making, constructing, using, and vending to others to be used, the said invention, as in and by the said letters-patent and schedule annexed, a true copy whereof is hereunto annexed and made a part hereof, will more fully and at large appear.

2. That the said Zenas Wheeler, after the issuance of said letters-patent, put the said invention into use, and made and used the same, and granted licenses to many persons to make, vend, and use the same for a valuable consideration, and that the same is of great utility, and has been extensively introduced into public use, and the public have generally acquiesced in the exclusive right of said Wheeler to the same; and ever since the date of the said letters-patent, down to and at the death of the said Wheeler, as hereinafter mentioned, he, the said Wheeler, had been and was entitled to all the rights, interest, and privileges thereby secured unto him in and to the said invention in said letters-patent particularly set forth, and entitled to the exclusive use of the said invention and improvement.

4 3. That the said Zenas Wheeler, being the sole owner of all the rights, interests, and privileges granted and secured by said letters-patent, departed this life on or about the 15th day of August, A.

D. 1869, at the time of his death being a resident of the city and county of San Francisco, in said State of California, and having estate therein, leaving a will duly executed as required by the laws of said State, whereby he gave, devised, and bequeathed to the plaintiff in this suit, all and singular his property, real and personal, wheresoever situated, all debts owing to him, and all moneys belonging to him of which he might die seized or possessed, in trust for certain uses and purposes, to wit: First, as to certain specific real estate in said city of San Francisco, for the use and benefit of one Mrs. Mary A. G. Page, wife of Charles S. Page, during her natural life, and on her death leaving issue, for the use and benefit of such issue, and in case of her death without issue, the same to be held by his executor named in said will, and disposed of with the residue or remainder of the estate of the said testator and upon the same trusts and conditions; second, as to the library
5 of the testator, for the use and benefit of said Mrs. Mary A. G. Page, except that he gave certain books loaned to his friends, and in their possession at his death, to such friends; and, third, as to all the residue or remainder of his property, real and personal, including several pieces of real estate in the said State of California, interests in patent rights, machinery, choses in action, moneys, and debts owing to him, the said testator left the same in the hands of his said executor to be managed, controlled, improved, changed, or disposed of as such executor might in his judgment deem best for the interest of the estate, and the moneys collected, realized, or produced, or that might come into the hands of said executor to be again invested, put at interest, or kept on hand, as he might deem best, with the direction to said executor, at any time within two years after the demise of the said testator that he might deem it requisite or in his judgment the exigencies of the case or the interests or wants of the parties might demand or require it, to make division of said residue or remainder of the said estate or the income thereof, giving to Amos Wheeler, the father of the said testator,
6 and Lucy A. W. Bean, half sister of said testator, one third of the same, to be equally divided between them during the natural life of the said Amos, and after his death said one-third to go to said Lucy A. W. Bean and her heirs forever; and with the further direction to said executor to use and expend one-third of said residue or remainder of said estate or the income thereof in perfecting certain inventions and improving certain machinery, in carrying out certain plans of which said executor was fully informed, and in works and deeds of charity, at his discretion; and as to the remaining one-third of said residue and remainder, for the use and benefit of the said plaintiff, and that in and by said will the said testator constituted the said plaintiff sole executor thereof.

4. That afterwards, to wit, on the 27th day of May, A. D. 1870, said will was duly proved and admitted to probate in and by the probate court of the city and county of San Francisco, in said State of California, which court had jurisdiction of the same under the constitution and laws of said State, and letters testamentary upon said will were
7 thereafter by said court duly granted and issued to the plaintiff as sole executor of said will, and he thereupon duly qualified and entered upon the discharge of his duties as such executor; that thereafter such proceedings took place in the matter of the estate of the said Zenas Wheeler deceased, in said probate court, that on or about the 16th day of December, A. D. 1872, all claims against said deceased, the debts of said estate and expenses of administration having been fully paid, and the administration of said estate closed, the said court duly

made its decree distributing all the property of the said estate, including the patent rights, interests, and privileges granted and secured by the said letters-patent to said Zenas Wheeler, and all claims and demands for any infringement thereof, in accordance with the terms and provisions of, and as directed in, said will, to wit, to the said plaintiff in trust for the uses and purposes aforesaid, as hereinbefore set forth, as by said decree now of record in said court will fully and at large appear; that no division was ever made by said executor of the portion of the estate of said deceased left by said will to said executor in trust
8 for the said Amos Wheeler and said Lucy A. W. Bean, and that by virtue of the said will and the decree of distribution aforesaid the plaintiff is the legal owner of the patent rights, interests, and privileges aforesaid, and of all claims and demands for any, in payment thereof, against all persons infringing the same.

5. That the defendants, well knowing the rights and privileges secured to him, the said Wheeler, and other the premises, and in order to deprive the plaintiff of the profits, benefits, and advantages which might and otherwise would have accrued to the plaintiff, have, without the license or possession of the said Wheeler, in his life-time, or of the plaintiff, and within the district of Nevada, to wit, in their mill at or near Dayton, in Lyon County, district aforesaid, since the issuance of said letters-patent, and since the death of said Wheeler, and within the said term of years in said patent mentioned, and before the commencement of this suit, used and caused to be used, and continue to use and cause to be used, twenty amalgamating machines, each and all containing and embracing substantially the improvement in machines for amalgamating gold and silver, or a material
9 part thereof, patented to the said Wheeler, in violation and infringement of the exclusive right secured by said letters-patent as aforesaid, and contrary to the form of the statute in such case made and provided, whereby the plaintiff has been greatly injured and deprived of great profit and advantage which he might and otherwise would have derived from said invention, and has sustained actual damage in the sum of two thousand dollars; and by force of the statute aforesaid an action has accrued to him to recover the said actual damage, and such additional amount, not exceeding in the whole three times the amount of such actual damage, as the court may see fit to order and adjudge. Yet the said defendants, though requested, have never paid the same or any part thereof to the plaintiff, but have refused and yet refuse so to do. Wherefore the plaintiff prays judgment against the defendants for the said sum of two thousand dollars, his actual damages, and that the same may be trebled according to the statutes aforesaid, making in all the sum of six thousand dollars, and costs of suit.

WILLIAMS & BIXLER,
Attys. for Plff.

10 No. 40874.

The United States of America to all to whom these letters-patent shall come:

Whereas Zenas Wheeler, of San Francisco, California, has alleged that he has invented a new and useful improved machine for amalgamating gold and silver, which he states has not been known or used before his application; has made oath that he is a citizen of the United States, that he does verily believe that he is the original and first inventor discoverer of the said invention, and that the same hath not, to the

best of his knowledge and belief, been previously known or used; has paid into the United States the sum of thirty-five dollars, and presented a petition to the Commissioner of Patents signifying a desire of obtaining an exclusive property in the said invention, and praying that a patent may be granted for that purpose: These are therefore to grant, according to law, to the said Zenas Wheeler, his heirs, administrators, or assigns, for the term of seventeen years from the eighth day of December, one thousand eight hundred and sixty-three, the full and exclusive right and liberty of making, constructing, using, and vending to
11 others to be used, the said invention, a description whereof is given in the words of the said Zenas Wheeler in the schedule hereunto annexed, and is made a part of these presents.

In testimony whereof I have caused these letters to be made patent, and the seal of the Patent Office has been hereunto affixed.

Given under my hand, at the city of Washington, this eighth day of December, in the year of our Lord one thousand eight hundred and sixty-three, and of the Independence of the United States of America the eighty-eighth.

J. P. USHER,
Secretary of the Interior.

Countersigned and sealed with the seal of the Patent-Office.
[SEAL.] D. P. HALLOWAY,
Commissioner of Patents.

The schedule referred to in these letters-patent and making part of the same.

To all whom it may concern:

Be it known that I, Zenas Wheeler, of San Francisco, in the county of San Francisco and State of California, have invented a new and improved gold and silver amalgamator and pulverizer; and I do
12 hereby declare that the following is a full, clear, and exact description of the same, reference being had to the accompanying drawings making a part of this specification, in which—

Fig. 1 is a vertical central section of my invention taken in the line x x, Figure 2; Fig. 2, a plan or top view of the same, with the cover of the pan removed; Fig. 3, a vertical central section of the lower part of the pan; Fig. 4, a plan or top view of the bottom of the pan.

Similar letters of reference indicate corresponding parts in the several figures.

The object of this invention is to obtain a device of simple construction, which will cause a thorough incorporation of the quicksilver with the pulp containing the metal, so as to ensure a perfect amalgamation of the latter. To this end the invention consists in the arrangement of fixed spiral ribs on the periphery of the rotary muller, and reversedly spiral ribs on the inner side of the pan, to operate in connection with curved grooves in the face or under side of the muller, and reversedly curved grooves in the bottom of the pan, as and for the purpose hereinafter fully explained. The invention also consists in the man-
13 ner of connecting the muller to its shaft by a universal joint, so as to insure its parallelism with the bottom of the pan. The invention also consists in the employment or use of curved plates, which are placed in the pan just above the muller, and arranged in such a manner as to be capable of being adjusted higher or lower, as hereinafter fully set forth.

By means of the rotary muller and the bottom of the pan the pulp is made to pass in a continuous current or flow over the top and underneath the muller, so as to ensure a perfect or thorough amalgamation of the metal contained in the ore with the quicksilver, while the curved plates are designed to prevent the pulp or ore being thrown out from the pan by the centrifugal force generated by the rotation of the muller.

To enable those skilled in the art to fully understand and construct my invention, I will proceed to describe it.

A represents a pan, which may be about four feet in diameter and about twenty-two inches in depth. This pan stands upon a frame, B, which may be of iron and provided with a horizontal iron top-plate, C, having a circular depression or recess, *a*, over which the pan is
14 placed, said depression or recess forming a steam-chamber by which the pan is heated in order to favor amalga'tion. The pan may be constructed of wood provided with an iron bottom, or it may be entirely of iron. The bottom of the pan, which is designated by *b*, has a series of curved plates, *c*, attached to its upper surface. These plates, *c*, are of such a shape that they form curved grooves, *d*, as shown in Figure 4, the plates being placed at such a distance apart as to admit of said grooves being of a requisite width, and the sides of the plates *c* are beveled, as shown in Figure 1, so as to be parallel with each other, but inclined. The plates *c* may be attached to the bottom *b* of the pan in any proper way to secure them firmly in position and still admit of their ready removal when worn by use, to be replaced by new ones. To the inner side of the pan A, just above the bottom *b*, there are attached a series of spiral strips, *e*. These strips are placed at equal and suitable distances apart, and extend entirely around the pan. D represents a muller, which is formed of a circular plate or disk, having a series of curved plates, *f*, attached to its under surface, to
15 form curved grooves precisely like the grooves *d* of the bottom *b* of the pan, but having a reverse position. The plates *f* are secured to the muller in any proper way that will admit of a firm connection and their ready removal or detachment from the muller when worn out by use, so that they can be replaced by new ones. To the edge or periphery of the muller there are attached a series of spiral strips, *h*, which are similar to the strips *e*, but have a reverse position to them. The muller D is attached by a universal joint, E, to a yoke, F, which is secured at its upper end to a shaft, G, said shaft passing down through an upright tube, H, which is attached to the center of the bottom *b* of the pan. The universal joint E is composed of a ring, *i*, which fits loosely on the tube H, and is provided at the opposite points with journals, *j*, which work in the lower end of the yoke F, and also provided at two opposite points with journals, *k k*, which work in bearings attached to the upper surface of the muller D. The lower end of the shaft G rests on a step, I, and directly over a lever, I', and said shaft is rotated by bevel-gears, J, the driving-shaft K of which has its bearings
16 in the frame B of the machine. The universal joint E ensures the parallelism of the muller D and bottom *b* of the pan A. L represents a series of curved plates, four, more or less. These plates are secured at their inner ends by screws or pins, *l*, and they each have a pin, *m*, projecting horizontally from them, and these pins are fitted in slides, *n*, which work in guides, *o*, attached to the inner side of the pan A. The inner ends of the plates L are secured by the screws or pins *l*, between two annular plates, *p p*, the upper one of which has a frame, M, attached to it, through the top of which a screw, *g*, passes vertically, and

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And now come the said defendants, by Beatty & Denson and Lewis & Deal, their attorneys, and defend the wrong and injury, when, &c., and say that they are not guilty of the supposed grievances above laid to their charge, or any or either or any part thereof, in manner and form as said plaintiff hath thereof complained against them, and they therefore deny each and every allegation made by said plaintiff in the said complaint herein filed against them.

And for a further answer and defence to the action, defts. allege that heretofore, on the day of December, 1863, and subsequent to the issuance of the letters-patent to Zenas Wheeler, described in said complaint, said Wheeler, for a valuable consideration, sold to H. J. Booth & Co. the right to manufacture and vend in the States of California and Nevada the pans described in said complaint, with the various things claimed to have been invented by said Wheeler, and for which said Wheeler is alleged to have obtained a patent; that afterwards, on the date last aforesaid, said defts., for a valuable consideration, and with the knowledge and consent of said Wheeler, purchased from said H. J. Booth & Co. the right to use and to continue to use in their [illegible]artz mill in Lyon County, State of Nevada, 20 of said pans, together [illegible]h the things described in said complaint, for which said Whe[illegible] [illegible]leged to have obtained a patent.

And for a further answer and defence to this action, defts. allege [illegible]t [illegible]e things alleged to have been invented by said Wheeler, and for which he is alleged to have received a patent, were not marked "patented," and that said defts. did not know the same were patented.

And for a further answer and defence to this action, defts. allege that the said pans, together with the things alleged by plff. in his complaint to have been invented by said Wheeler, and for which he is alleged to have received a patent, have been, from the time when the said invention is alleged to have been made by said Wheeler to the present time, openly and universally used by the public, and that such use was with the knowledge and consent of said Wheeler and that said Wheeler, by permitting and consenting to said use, voluntarily abandoned the said alleged invention and patent and all rights alleged to have been aquired by him by virtue of said letters-patent.

Wherefore defts. pray that this action be dismissed, and that defts. have and recover from said plff. their costs in this behalf expended.

BEATTY & DENSON AND
LEWIS & DEAL,
Attys. for Defts.

We certify that the foregoing answer is well founded in point of law.

LEWIS & DEAL.

22 *Notice of special matter.*

In the circuit court of the United States for the district of Nevada.

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The defendants having heretofore answered in this case, it is suggested by the court now here that, as provided in section sixty-one of the act of Congress approved July 8th, A. D. 1870, entitled "An act to revise, consolidate, and amend the statutes relating to patents and copyrights," the defendants give to the plaintiff, thirty days before the trial, the following notice of special matter respecting the invention and discovery, principle and combination, patented in and by the letters-patent mentioned in the complaint of plaintiff, and described in said letters-patent and the specifications and drawings thereto attached, which are made a part of said complaint, and are now referred to for a more particular description of the said patent:

First. Take notice that the above-named defendants will prove upon the trial of this cause, in bar of the plaintiff's action, that the prin-
23 cipal part of the said invention and discovery, to wit, the curved grooves in the face of the muller and in the bottom of the pan, and also the same principle and combination patented in and by the letters-patent mentioned in plaintiff's complaint, were patented on the fifteenth day of June, A. D. 1858, by letters-patent granted and issued to John A. Wilson, of Dover, in the State of New Jersey; also on twentieth day of July, A. D. 1858, to one George W. Lay, of Jefferson, Texas; also to one Henry Brevoort, of San Francisco, California, on the 20th day of August, A. D. 1859, and on the thirteenth day of May, A. D. 1862, to one Almarin B. Paul, who then resided in Silver City, State of Nevada, all of which were prior to the supposed invention and discovery thereof by Zenas Wheeler, the patentee mentioned in the complaint herein; and the curved plates marked "L" in the diagram attached to the said complaint, and the same principle and combination, were patented on the sixteenth day of December, A. D. 1862, by letters-patent granted and issued to one Thomas Varney, then living in San Francisco, in the State of California, and prior to the supposed invention and discovery thereof by the said Zenas Wheeler.

Second. That the said Zenas Wheeler, patentee as aforesaid, was not the original and first inventor and discoverer of the said
24 invention and discovery, or of any material or essential part of the things or of the principle or combination patented in and by the letters-patent mentioned in the plaintiff's complaint, but that the same things and the same principle and combination had been previously combined by and invented and discovered by one Henry Brevoort, who resides in the city of New York, State of New York, and also by one Thomas Varney, who resides in the city of San Francisco, in the State of California, and the same was known to and combined by the said Brevoort and the said Varney as early as A. D. 1860, and prior to the time when the same is claimed to have been invented and discovered by the said Zenas Wheeler, patentee as aforesaid.

Third. That the said Zenas Wheeler, patentee as aforesaid, was not the original or first inventor and discoverer of the said invention and discovery of the curved grooves in the face of the muller and bottom of the pan, or of the curved plates marked "L" in the diagram attached

to the complaint herein, or of any material or essential part of the things and the principle or combination patented in and by the letters-patent mentioned in the plaintiff's complaint, but that the same
25 things and the same principle and combination were known to James A. Rigby, now living in Carson City, State of Nevada; Albert Horn, living in Silver City; A. P. Hornick, of Virginia City; C. C. Stevenson, of Gold Hill; Ira S. Parke, of Virginia City; Dean Lyman, of Empire City; John W. Varney, living in Virginia City, all of the State of Nevada aforesaid, as early as the first day of January, A. D. 1860, and prior to the time when the same is claimed to have been invented and discovered by the said Zenas Wheeler, patentee as aforesaid; and that the said parties knew of the use of the said things and combination patented as aforesaid at the various mills mentioned in the fourth notice of special matter herein as early as the date last aforesaid.

Fourth. That the said invention and discovery, the curved plates L and the curved grooves in the face of the muller and bottom of the pan, and the same principle and combination patented in and by the letters-patent mentioned in the complaint herein, were in public use in the United States in the following mills, and used by, and the use thereof known to, the following-named persons, to wit: In the Rigby mill, located on American Flat, in the county of Storey, State of Nevada, the same being used by, and the use thereof known to, James A.
26 Rigby, now living in Carson City, State aforesaid; in the French mill, located in Silver City, State of Nevada, by Joseph French and Albert Horn, now living in Silver City, State aforesaid; in the Silver City mill, located at Silver City, by said Horn; in the Brevoort mill, (now Bacon,) near Gold Hill, by Henry Brevoort, who now resides in the city of New York, State of New York; in the Kelsey mill, located at Silver City aforesaid, by one Kelsey, who now resides in San Francisco; in the Dancy mill, situated near Silver City aforesaid, such use being known to the said Horn; in the Succor mill, near Gold Hill, the use thereof being known to John W. Varney, of Virginia City, State of Nevada. The same was also used by the said Varney, to his knowledge, at the Miners' foundry in the City of San Francisco, State of California, as early as January, A. D. 1860, and had been in such use for more than two years before the time when the said Wheeler made application for his patent therefor.

Fifth. That the said invention and discovery, the curved plates L, and also shoes and dies, with the curved grooves in the muller and bottom of the pan, and the same things and combination patented in and by the letters-patent mentioned in the complaint herein, were
27 on sale at the Miners' foundry, in the city of San Francisco, State of California, at Booth & Co.'s foundry, in the cities of Sacramento and Marysville, in the said State, and at the Pioneer foundry, in Virginia City, State of Nevada, as early as January, A. D. 1860, and more than two years prior to the time the said Wheeler made application for his said patent.

Sixth. That the said invention and discovery, the curved grooves, and the same principle and combination patented in and by the letters-patent mentioned in the plaintiff's complaint, were mentioned and described in a printed publication, that is to say, in The Young Millwright and Millers' Guide, by Oliver Evans, published in the year 1834, and the fifteenth edition, in the year 1860, by Blanchard & Lea, in Philadelphia, in the State of Pennsylvania, a publication published, issued, and publicly circulated and distributed prior to the supposed invention and discovery

by the said Zenas Wheeler, the patentee aforesaid of the said invention, discovery, and combination, the said description being in the fifteenth edition of the said book, in chapter 13, article 104, pages 256 to 262 inclusive, in connection with plate or figure eleven; also in chapter 21, article 145, of the same book.

28 BEATTY & DENSON, AND
LEWIS & DEAL,
Attys. for Defts.

To Messrs. WILLIAMS, BIXLER & STONE,
Attys. for Plff.

(Endorsed:) C. C. Coolidge, plff., v. F. Birdsall et al., defts. Notice of specal matter to be proven. Beatty & Denson and Lewis & Deal, attys. for defts. Due service of a copy of this notice admitted this 27th day of June, A. D. 1873. Wms. & Bixler, attys. for plff. Filed June 28, 1873. R. M. Daggett, clerk, by Thos. J. Edwards, dep. clerk.

In the circuit court of the United States for the district of Nevada.

C. C. COOLIDGE
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F. BIRDSALL AND GEORGE F. LANGTRY, DEfendants.

The defendants suggest to the court now here that, as provided in section sixty-one of the act of Congress approved July 8, 1870, entitled "An act to revise, consolidate, and amend the statutes relating to
29 patents and copyrights," the defendants give to the plaintiff, thirty days before the trial, the following additional notice of special matters respecting the invention and discovery, principle and combination, patented in and by the letters-patent mentioned in the complaint of plaintiff, and described in said letters-patent and the specifications and drawings thereto attached, which are made a part of said complaint, and are now referred to for a more particular description of the patent:

First. Take notice that the above-named defendants will prove upon the trial of this cause, in bar of the plaintiff's action, that the said F. G. Belknap, patentee as aforesaid, was not the original or first inventor and discoverer of the said invention and discovery of the curved grooves in the bottom of the pan and face of the muller, of the angle at which such grooves are placed, or of the curved plates marked "L," in the diagram attached to the complaint herein, or of any essential or material part of the things or of the principle or combination patented in and by the letters-patent mentioned in the plaintiff's complaint, but that the
30 same things and the same principle and combination were known to Guido Kustel, now living at 727 Harrison street, San Francisco, California, as early as the years 1861 and 1862, and George Emmett, now residing at Gold Hill, Storey County, State of Nevada, as early as the year 1844, and long prior to the time when the same is claimed to have been invented and discovered by the said F. G. Belknap, patentee as aforesaid, and the said parties knew of the use of said things and principle and combination as aforesaid at the various places mentioned in the following notice of special matters here given.

Second. That the said invention and discovery, the curved plates marked "L," and the curved grooves in the face of the muller and bottom of the pans, and the same principle and combination patented in

and by the letters-patent mentioned in the complaint herein, were in public use in the United States at the following places, and used by, and the use thereof known to, the following persons respectively, to wit: At the Ophir Reduction Works, near Franktown, Washoe County, in the then Territory of Nevada, by Guido Kustel, now residing
31 at 727 Harrison street, San Francisco, California, in the years 1861 and 186'; at a plaster mill near Syracuse, in the town of Camillus, State of New York, by George Emmett, as early as the year 1844, to the knowledge of George Emmett, now residing at Gold Hill, Storey County, State of Nevada; at the Vine Street Mills, in the city of Des Moines, Iowa, by Hantsel & Zeigler, as early as the year 1853, to the knowledge of Wm. H. Armstrong, residing at Gold Hill, Storey County, Nevada.

Dated Oct. 31, 1873.

BEATTY & DENSON, &
LEWIS & DEAL,
Attys. for Defts.

To Messrs. WILLIAMS & BIXLER,
Attys. for Plff.

(Endorsed:) U. S. circuit court, district of Nevada. C. C. Coolidge v. F. Birdsall et al. Notice of special matter to be proven. Service of a copy of the within notice acknowledged Oct. 31, 1873. Williams & Bixler, attys. for plff. Filed Nov. 1, 1873. R. M. Daggett, clerk, by T.
32 J. Edwards, dep. clerk. counsel for defts.

Due service of this answer acknowledged this 17th day of May, A. D. 1873.

WILLIAMS & BIXLER,
Attys. for Plff.

(Endorsed:) U. S. circuit court, district of Nevada. C. C. Coolidge v. F. Birdsall et al. Answer. Filed May 19, 1873, at 10 o'clock a. m. R. M. Daggett, clerk, by T. J. Edwards, dep. clk.

In U. S. circuit court, district of Nevada.

COOLIDGE
v.
BIRDSALL ET AL.

We, the jury in the above entitled cause, do find a verdict for the plaintiff in the sum of twenty-two hundred sixty-six dollars and sixty-six cents.

Carson, Dec. 5, 1873.

JAS. W. SMALL,
Foreman.

(Endorsed:) Filed Dec. 5, 1873. R. M. Daggett, clerk, by T. J. Edwards, dep. clk.

In the circuit court of the United States for the district of Nevada. December term, A. D. 1873.

33 C. C. COOLIDGE, PLAINTIFF,
v.
F. BIRDSALL & GEO. F. LANGTRY, DEFENDANTS. } At law.

In accordance with the verdict of the jury this day rendered in said

cause, and in pursuance of the law in such case made and provided, it is ordered and adjudged that the said plaintiff, C. C. Coolidge, do have and recover of and from the defendants, F. Birdsall and Geo. F. Langtry the full sum of two thousand two hundred and sixty-six $\frac{66}{100}$ ($2,266.66) dollars, in lawful money of the United States, together with his legal costs and disbursements incurred in and about said action, hereby taxed at $354.75.

Dec. 5, 1873.

34 In the circuit court of the United States for the district of Nevada.

C. C. COOLIDGE, PLAINTIFF,
vs.
F. BIRDSALL AND GEORGE F. LANGTREE, defendants.

Be it remembered that this cause came on and was regularly tried by the court, with a jury, on the second, third, fourth, and fifth days of December, A. D. 1873.

The plaintiff, to maintain the issues upon his part, introduced in evidence letters-patent No. 40874, granted by the United States Government to Zenas Wheeler on the eighth day of December, A. D. 1863, for an improved machine for amalgamating gold and silver. A copy of said letters-patent, together with the specifications, claims, and drawing thereto attached, are hereto annexed, marked "Exhibit A," and are hereby referred to and made part of this bill of exceptions. Also evidence tending to show that the said Zenas Wheeler died on the 15th day of August, A. D. 1869, leaving a will in which he devised said letters-patent to the plaintiff.

35 It was admitted as a fact on the trial that the defendants had not infringed either the first or second claim in said letters-patent.

The plaintiff also introduced evidence tending to show that in the summer of A. D. 1869 the defendants purchased twenty amalgamating pans. In the month of September, A. D. 1869, the defendants used them for the first time; that said amalgamating pans contained wings, so called, which were curved plates of iron twelve inches wide and fourteen inches long, and were fastened at one end to the inner side of the rim of the pans in a vertical position in such manner that they could be raised or depressed by sliding up or down in a groove or fastening, and adjusted at different h'ights, and extending lengthways towards the center of the pans, which were a little more than four feet in diameter.

The so-called wings were used in only sixteen of said pans for a few weeks after the defendants began using said pans for amalgamating purposes, when the defendants, as they testify, finding that the said wings were useless and even detrimental in said pans for the work which they were performing with said pans, viz, working over old tailings, which did not require further grinding or pulverization, took

36 them out of the sixteen pans and sold them for old iron. In working tailings they did not let the muller down so as to use it for grinding. At first the mill was used as a quartz-mill, in which it was necessary to grind. So long as the mill was so used said wings were used; but when they ceased to use it as a quartz-mill and worked tailings, they took out the wings. Then was the time they became useless. They never used them in the other four pans.

This user of said wings in said pans in combination with the pan and

muller was the only thing done by the defendants which infringed, or which the plaintiff claimed infringed, the said letters-patent. The defendants took the wings out of four of said pans before they used them, and in some of the other pans only used them for a short time, and did not use any of them more than six weeks.

The plaintiff, in order to prove the damages sustained by him on account of the alleged infringement, introduced testimony tending to prove that Zenas Wheeler in his life-time had allowed manufacturers to make and sell his invention for a royalty of one hundred dollars upon each pan sold, which contained only the combination claimed to have been infringed. He also proved that he had sold royalties
37 to a large amount at the rate of one hundred dollars per pan. This was all the evidence tending to show the extent of the damages.

The defendants, in order to aid in the proper construction to be given to said third claim of said letters-patent, by showing the state of the art at the time said Wheeler made his inventions, and for the purpose of showing that Wheeler was not the original and first inventor of the wings or curved plates mentioned in his specifications, introduced in evidence United States letters-patent, bearing date on the 16th day of December, A. D. 1862, granted to Thomas Varney for improved amalgamators. A copy of said letters-patent, together with the specifications, claims, and drawings thereof, are hereto annexed, marked "Exhibit B." and are here referred to and made a part of this bill of exceptions.

The defendants also introduced evidence tending to show that at least one year before said Wheeler made his said invention he, Wheeler, had seen a model of the pans made as described in Exhibit B, and had seen it at work with the curved scrapers, as they are called, in it.

Evidence was also introduced tending to show that the curved
38 scrapers in the Varney pan worked to some extent upon the same principle, and carried the pulp from their outer sides to the center of the pans in substantially the same manner as did the plates L in the plaintiff's patent, & tending to show that whilst they were patented and used mearly as scrapers, still that to a less extent they did produce the same result in the same way as the curved plates L. But the scrapers used by Varney before the date of Wheeler's patent were narrower than the plates used by Wheeler, being two inches wide, while Wheeler's plates were eight inches wide. Wheeler's extended to and were attached to the sides of the pan by means of a groove, in which it could slide up and down, so as to be adjustable at any required distance from the muller. Varney's scrapers only extended to the edge of the muller, resting upon the muller, and terminated four and a half inches distant from the side of the pan.

No evidence was introduced tending to show that any amalgamating pans ever made, or caused to be made, or licensed to be made, by said Wheeler, or made under Exhibit A, or according to the description contained in Exhibit A, were ever marked with the word "patented" or "patent," or with the date of the plaintiff's patent, or by any
39 word, mark, or sign of any kind showing that they, or any part or parts, or combination of parts in them were covered or protected by any letters-patent; but the defendants introduced evidence showing that H. J. Booth & Company manufactured, in the city of San Francisco, with the knowledge and assent of Zenas Wheeler, twenty of said pans, and sold them to defendants, F. Birdsall & Co., of Lyon County, Nevada, to be used in their mill at Dayton, Lyon County, Nevada, called the Birdsall & Co. Mill, and that they were put up and used by defend-

ants in said mill. The testimony of defendants, Birdsall and Langtree, tended to show that the word "patented" was not marked or imprinted on any part of said pans or machinery, or any other mark or device showing or tending to show tnat they had ever been patented; that there would have been no difficulty in fixing, imprinting, or marking the word "patented," or any other words or figures, either on the pan itself or the muller or on the wing, the combination of which three elements was claimed to have been patented and infringed. It was shown that Wheeler received a royalty of one hundred dollars per pan on these twenty pans under claim of his patent of December, 1863; that
40 this royalty was received on the combination only claimed to be infringed. These twenty pans were called improved Wheeler pans, had the twelve by fourteen inch wings in them, and were precisely similar to the pans which are charged by plaintiff to have been used in violation of his patent.

Upon these points there was no contradictory evidence.

It was also shown by uncontradicted evidence that the defendants subsequently to the purchase of said twenty pans from Booth & Co., purchased thirteen of the said twenty pans which they are charged with having used in violation of plaintiff's patent from John McCone, who manufactured them at Silver City, in said Lyon County, Nevada, and purchased the other seven of said twenty pans of A. L. Greely, who manufactured them at Virginia City, Storey County, Nevada, and said last-named twenty pans were used by defendants in the same mill, and in connection with said first-named twenty similar pans before purchased of said Booth & Co., and upon which said defendants had paid said royalty of one hundred dollars per pan.

The testimony of said Greely and McCone respectively, who were engaged in the manufacture and sale of said pans sold by
41 them respectively to said defendants, tended to show that before said twenty pans were made and sold by them to defendants said Wheeler saw, at their respective shops, other pans of their manufacture made like those sold defendants, except that said pans seen by him did not at the time seen actually have in them the said curved wings or plates, and the pan of the said Greeley did not have in it any groove or appliance for inserting said wing, but the said McCone's pan had a groove cast in the side of the pan for the purpose, in which the wing could be inserted, and both had lying in their shops, where they could and were likely to have been seen by Wheeler, wings to be inserted in said pans by parties desiring them, and Greeley had lying with his wings slots for inserting said wings in seperate pieces to be bolted to the side of his pans, which is accomp'ished by the purchasers by drilling holes in the pan and bolting the slot to the side of the pan; that each asked Wheeler if his said pan in any way infringed his, Wheeler's said patent, and that Wheeler in each case replied that the said pans did not in any way infringe upon his patent. But no
42 particular reference was made in either case to said wings, and neither witness could say whether Wheeler did in fact see said wings; but there was no testimony tending in any degree to show that these conversations with Wheeler, or Wheelers' said declarations, were any of them ever brought to the knowledge of said defendants or either of them.

The only evidence introduced showing or tending to show that the defendants had any notice that Wheeler or the plaintiff had a patent or claimed a patent upon pans, muller, and wings similar to those purchased by them from said McCone and Greeley was that defendant

Birdsall had, before said last-named purchase, purchased for himself and partner, from H. J. Booth & Company, the aforesaid twenty pans called the improved Wheeler pans, which are similar to the twenty pans purchased of Greeley and McConc; and that at the time he was making that purchase Wheeler and Booth both informed him, Birdsall, that Wheeler had a patent on these pans, and that Booth paid Wheeler a royalty of one hundred dollars per pan for the privilege of making and selling said pans, which royalty said defendant Birdsall paid to Booth & Co. for the twenty pans so purchased; and the further testimony that in the month of September, 1869, before
43 the use of said pans bought of McCone & Greeley, the present plaintiff, claiming to act as the agent of Zenas Wheeler, notified the defendant Langtree (then the partner of defendant F. Birdsall) that in putting up the pans mentioned in the complaint he was violating Wheeler's patent, and demanded of him the royalty; that defendant Langtree thereupon promised to confer with his partner, Birdsall, in regard to the payment of the royalty claimed, and let Coolidge know their determination on Coolidge's return from Idaho. This was after the pans had been purchased of McCone and Greeley, and whilst they were being put in place preparatory to running, but before using them. Both the defendants, Birdsall and Langtree, testified that they had no knowledge as to what part Wheeler claimed to have patented in his improved machine for amalgamating gold and silver, and did not know that the pans they were purchasing from McCone and Greeley, were in any manner an infringement of Wheeler's patent, and Langtree testifies that he does not remember the conversation testified to by Coolidge on the subject. The foregoing is the only testimony
44 upon the question of notice by defendants, Birdsall and Langtree, of Wheeler's patent.

It was also shown that Wheeler, in all pans manufactured and sold under his patent at the time, had dispensed with the improvements covered by the first and second claims in his patent, and that no part of what Wheeler originally specified and claimed as his invention and covered by said patent was contained in the pans his agent sold to Birdsall & Co., except the curved wing in combination with the revolving muller and pan, the curved wing having been by Wheeler substituted in the said combination for the curved plates L, described in Wheeler's patent; and the combination of the wing, thus substituted for the curved plate L, with the revolving muller and pan, was all the portion contained in the Greeley and McCone pans which was claimed by the plaintiff to have infringed his rights.

During the progress of the trial counsel for defendants asked the witness, F. Birdsall, "With regard to these wings that were sent there with the Greeley and McCone pans, did you consider them of sufficient value to have retained them, if you had been told there was a claim of patent-right upon them?"

45 Counsel for plaintiff objected to the question as irrelevant.

Counsel for defendants insisted that the evidence was pertinent to the question of damages, but the court sustained the objection to the evidence, and refused to allow the witness to answer.

To which ruling the defendants' counsel then and there excepted, and prays that the same may be allowed, signed, sealed, and made a part of the record.

It appeared from the testimony, there being no testimony to the contrary, that the muller and pan used by defendants did not have the spiral ribs *h* affixed to the periphery of the muller, or the reversedly

spiral ribs *e* affixed to the inner side of the pan, in combination or otherwise, with the curved groove *g* in the face of the muller, and reversedly curved grooves *d* in the bottom of the pan; which ribs, grooves, and combination are specially referred to in, and covered by, the first claim in Wheeler's patent. Neither said spiral ribs, in combination with curved grooves, nor any substitute therefor, were used by defendants. But it appeared that the defendants used the curved wings,
46 hereinbefore described in combination with a revolving muller and pan in other respects like Wheeler's muller and pan. It also appeared that the said spiral ribs and combinations, with said curved grooves mentioned in the said first claim in Wheeler's patent, had been, at the time of said infringement, dispensed with by said Wheeler in the pans manufactured and sold by him and by his authority under his said patent, and the testimony tended to show that Wheeler himself had first substituted the said curved wings for the curved plates in the combination of curved plate, muller, and pan described in his third claim, claimed to have been infringed by the defendants, and that he did not apply for a patent for the substitute wing, for the reason that he was advised and believed that it was but a mechanical substitute for the curved plate described in the patent, and as such was protected by the patent already issued.

The evidence of plaintiff and defendants being closed, and before the commencement of the argument to the jury, defendants' counsel asked the court to give the jury the following written instruction:

"The Wheeler patent here introduced in evidence, so far as this case is concerned, is for a combination of the curved plates and the pan and muller described in the specifications and patent. As there
47 is no proof that the wings or curved plates were ever used in connection with the pan and muller described, you must find for the defendants."

The court refused the instruction; to which refusal the defendants' counsel then and there duly excepted, and asked that the same might be signed, sealed, and allowed as an exception in the case.

The counsel of the respective parties then argued the cause, after which the court charged the jury, and, among other things, as follows, to wit:

"There is testimony given here by the various witnesses as to whether it was or not useful. That testimony you must consider, and I will say in regard to it that the testimony that they have gone extensively into use is testimony tending strongly to prove their usefulness. Testimony that it has been bought and used is evidence of its usefulness, because people are not generally in the habit of buying things and using them which they do not deem useful. If there was any other thing before known, or any other thing not patented, that would produce the same results, parties are at liberty to use them, and need not pay a royalty upon a patent if they have got a thing which they can use to accomplish the same purpose; and the very fact that they do purchase
48 and use a patented instrument is evidence of itself tending to show that it *it* is useful; but whether it is sufficient or not is a question for the jury to determine."

After the close of the charge to the jury, and in presence of the jury, the counsel for the defendants objected to this part of the charge, on the ground that the usefulness of the machine could not be inferred from the sale and purchase of the machines, unless it were shown that the purchasers had seen the machine in operation, and were thereby qualified to judge of its usefulness. The judge thereupon qualified this part

of his instructions by saying, "I say it is a circumstance which they are entitled to consider in reference to the other testimony on the subject if you except to it in that form. I say these facts are facts for the jury to consider, and *and* give them such weight in connectien with the other testimony as they think they are entitled to," and refused to strike out or otherwise modify.

The defendants' counsel still objected to the instructions as qualified, and excepted to the ruling of the court sustaining the same; which exception is here now tendered to the court and asked to be signed, sealed, and made a part of the record.

The court also gave, among other instructions, the following:

49 "I had some doubt on the rule of damages in the *agreement* of this case; but upon the whole I don't see any other way than to adopt the ordinary rule in such cases where a royalty has been established, & make the royalty the measure of damages. I don't see that any other rule in reference to this particular class of cases, where a person without leave or license appropriated the plff.'s invention, although he afterwards abandoned it. If, then, you find any damages, the damages will be the royalty which he obtained for this particular part of his invention. If a royalty of $100 was paid for this invention, then there would be $100 on each pan so used, & interest upon that sum at the rate of interest in this State, 10 p'r cent. per annum from the date of the appropriation, say from the 1st of October, 1869."

To this instruction the defendants objected in the presence of the jury, and before they retired, and asked the court to modify the instruction to this extent: that if they were satisfied from the evidence in this case that the plaintiff could not have obtained the royalty in this case, and that defendants would not have used the wings if they had known they were prohibited by patent. But the court refused to modify the

50 instruction in any respect, and therefore the defendants' counsel excepted to the ruling of the court in giving said instruction, and also in refusing to modify the same; and he now tenders this bill of exceptions, and asks that the same may be signed, sealed, and made a part of the record.

The court further instructed the jury that if they found that the plaintiff's patent covered a new and useful invention, and it had been infringed by defendants, they might find for the plaintiff, although they did not find any damages for him.

To this part of the charge the defendants' counsel objected in the presence of the jury, and before they retired to consider their verdict. The court refused to strike out or modify this part of its charge. The counsel for defendants duly excepted, and here now present their bill of exceptions, and pray that the same may be signed, sealed, and made a part of the record.

And further, with reference to the question of damages, the court read to the jury the statute requiring all articles made or vended by any party under the protection of a patent to be stamped or labelled with the word patented, and date of the patent, and providing that on failure to so stamp or label the article, in an action for infringe-

51 ment of the patent by the party failing so to mark the article the right to which is infringed, no damage shall be recovered by the plaintiff except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make or vend the article patented; and then, in relation to said provision, charged the jury as follows:

"I instruct you, gentlemen, that it is sufficient if the patentee

stamped the word 'patented' and the date of the patent in any reasonably conspicuous place on the completed pan. It is not necessary to put it on each part covered by a distinct claim; but if it was stamped in any reasonably conspicuous place upon the completed patented article, then the plaintiff is entitled to recover his damages."

But the court further instructed the jury on the question "that if those pans purchased of Booth & Co. were not stamped as required by this statute, and it was proved to your satisfaction, then the plaintiff is not entitled to recover damages for the use of the other pans subsequently purchased of other parties, unless defendants had notice of the patent." The counsel for the defendants, in the presence of the jury, and at the conclusion of the judge's charge, did then and there duly object
52 and except to this part of the charge, so far as it relates to the place where it may be stamped, and insist that the mark or stamp must be put on the very article patented, (to wit, in this case upon the wing,) and not upon the pan and muller generally for which a patent is claimed. But the court overruled the objection, and allowed the charge to stand as originally given. To this ruling the defendants' counsel duly excepted, and here now tender their bill of exceptions, to be signed, sealed, and made a part of this record.

The court further gave, among others, the following instructions:

"There is testimony here by the plaintiff that before these pans were started, and while they were being put up, he had a conversation with one of the defendants, Mr. Langtree, about the payment of the royalty upon these very pans, indicating to the defendants that there was a patent upon those pans which he was infringing if he used them, and calling for the royalty. He testified that he said he was going to Idaho at the time and would return in a few weeks, and that Langtree said he would consult with his partner about it, and let him, Coolidge, know when he came back.

"Langtree, on the other hand, testifies that he has no recol'ection
53 of any such conversation. He said there was no such conversation took place. This a question for you to determine between them. If Langtree had that notice, that would be sufficient under this statute to bring notice home to him; if he was informed that there was a patent on them, (these pans,) that was sufficient to put him upon inquiry, and he was bound to pursue it and see what particular part of that machine it covered. So that if they had actual notice in either of these modes, if it was such as to satisfy you that they had notice of the existence of this patent, or notice of such facts as made it obligatory upon them to ascertain the exact facts, it is sufficient for this purpose; and if they had this notice, and there was a violation of his patent, the plaintiff is entitled to damages."

To this part of the charge the defendants objected in the presence of the jury, and before they retired to consider their verdict, & requested the court to withdraw the same, but the court overruled the objection and sustained that part of the instructions; to which ruling the defendants excepted, and ask that the same may be signed, sealed, and made a part of the record.

The court further gave, among others, the following instructions:

54 "If defendants had notice of this patent, and there was an infringement by them after such notice, although the pans purchased of Booth & Co. were not stamped, still the plaintiff is entitled to recover damages."

To this part of the charge the defendants' counsel, in the presence of the jury, & before they retired to consider their virdict, objected, but

the court, after having its attention called to this part of the charge, refused to withdraw the same, and overruled the defendants' objection; to which ruling the defendants' counsel then and there duly excepted, and here now prays this exception to be signed, sealed, and made a part of the record.

After the close of the testimony the defendants' counsel, in due time and form, requested the court to give to the jury, among others, the following written instructions, viz: If the jury believe from the evidence that John McCone exhibited to Zenas Wheeler, in the month of October, 1868, a finished pan precisely like the thirteen pans that he furnished to Birdsall & Co., the defendants, in the year 1869, and asked the said Wheeler if the making of these pans was an infringement of his patent, and the said Wheeler, with a full knowledge of the fact that the
55 wings described in the first instruction asked by defendants, and substantially the same as the short wings in the brass model shown the jury, were a part of and ready made and fitted to be attached to said pan, told the said McCone that such pan as then manufactured was not an infringement on his patent, then the defendants, as venders of said McCone, are protected as to the thirteen pans sold to them by McCone, and no recovery can be had against them on account of using the wings in the McCone pans.

If the jury believe from the evidence that in the year 1867 A. L. Greeley was manufacturing pans precisely similar to the seven (7) pans which he furnished the defendants in 1869, in all respects, except that the pans furnished defendants were larger than those manufactured in 1867, and that Zenas Wheeler, in the aforesaid year of 1867, called on said Greeley to ascertain in what particular the said Greeley was violating his patents or manufacturing articles on which he claimed a royalty, and the said Wheeler knew that the pans then being manufactured were to contain wings in the inner periphery of the pan similar to the short wings on the brass model now before the jury, and did settle
56 with the said Wheeler for all the royalties by him claimed, and did at the same time inform the said Greeley that the pan thus manufactured by Greeley was not a violation of his, Wheeler's patent, and the said Wheeler, relying on said declaration, did continue to manufacture and sell such pans with the wings, then the defendants are not liable for having used the wings in the pans furnished by Greeley in the year 1869.

Which said instructions were refused on the ground, among others, that there is no testimony tending to show that the declarations of Wheeler referred to in the instances, if made, were brought to the notice of the defendants, and that this element of estoppel is wanting; to which refusal defendants duly excepted, and they here now tender this bill of exceptions and pray that the same may be signed, sealed, and made a part of the record.

In testimony whereof, and of the truth of the foregoing bill of exceptions, I, the said judge, before whom the said cause was tried, have hereunto set my hand and seal this fifth day of January, A. D. 1874.

LORENZO SAWYER, [SEAL.]
Circuit Judge.

57 No. 40874.

The United States of America to all to whom these letters-patent shall come:

Whereas Zenas Wheeler, of San Francisco, California, has alleged

that he has invented a new and useful improved machine for amalgamating gold & silver, which he states has not been known or used before his application; has made oath that he is a citizen of the United States, that he does verily believe that he is the original and first inventor or discoverer of the said invention, and that the same hath not, to the best of his knowledge and belief, been previously known or used; has paid into the Treasury of the United States the sum of thirty-five dollars, and presented a petition to the Commissioner of Patents signifying a desire of obtaining an exclusive property in the said invention, and praying that a patent may be granted for that purpose:

These are therefore to grant, according to law, to the said Zenas Wheeler, his heirs, administrators, or assigns, for the term of seventeen years from the eighth day of December, one thousand eight hundred & sixty-three, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said
58 invention, a description whereof is given in the words of the said Zenas Wheeler in the schedule hereunto annexed, and is made a part of these presents.

In testimony whereof I have caused these letters to be made patent, and the seal of the Patent-Office has been hereunto affixed.

Given under my hand, at the city of Washington, this eighth day of of December, in the year of our Lord one thousand eight hundred and sixty-three, and of the Independence of the United States of America eight'-eight'.

J. P. USHER,
Secretary of the Interior.

Countersigned and sealed with seal of the Patent-Office.
[SEAL.] D. P. HOLLOWAY,
Commissioner of Patents.

The schedule referred to in these letters-paten and making part of the same.

To all *to* whom it may concern:

Be it known that I, Zenas Wheeler, of San Francisco, in the county of San Francisco and State of California, have invented a new and improved gold and silver amalgamator and pulverizer; and I do
59 hereby declare that the following is a full, clear, and exact description of the same, reference being had to the accompanying drawings, making a part of this specification, in which—

Fig. 1 is a vertical central section of my invention taken in the line x x, Figure 2.

Fig. 2, a plan or top view of the same, with the cover of the pan removed.

Fig. 3, a vertical central section of the lower part of the pan.

Fig. 4, a plan or top view of the bottom of the pan.

Similar letters of reference indicate corresponding parts in the several figures.

The object of this invention is to obtain a device of simple construction, which will cause a thorough incorporation of the quicksilver with the pulp containing the metal, so as to ensure a perfect amalgamation of the latter. To this end the invention consists in the arrangement of fixed spiral ribs on the periphery of the rotary muller, and reversedly spiral ribs on the inner side of the pan, to operate in connection with

curved grooves in the face or under side of the muller, and reversedly curved grooves in the bottom of the pan, as and for the purpose hereinafter fully explained.

The invention also consists in the manner of connecting the
60 muller to its shaft by a universal joint, so as to insure its *its* parallelism with the bottom of the pan.

The invention also consists in the employment or use of curved plates, which are placed in the pan just above the muller, and arranged in such a manner as to be capable of being adjusted higher or lower, as hereinafter set forth.

By means of the rotary muller and the bottom of the pan the pulp is made to pass in a continuous current or flow over the top and underneath the muller, so as to ensure a perfect or thorough amalgamation of the metal contained in the ore with the quicksilver, while the curved plates are designed to prevent the pulp or ore being thrown out from the pan by the centrifugal force generated by the rotation of the muller.

To enable those skilled in the art to fully understand and construct my invention, I will proceed to describe it.

A represents a pan, which may be about four feet in diameter and about twenty-two inches in depth. This pan stands upon a frame, B, which may be of iron and provided with a horizontal iron top-plate, C, having a circular depression or recess, *a*, over which the pan is placed, said depression or recess forming a steam-chamber by which the
61 pan is heated in order to favor amalgamation. The *the* pan may be constructed of wood provided with an iron bottom, or it may be entirely of iron. The bottom of the pan, which is designated by *b*, has a series of curved plates, *c*, attached to its upper surface. These plates, *c*, are of such a shape that they form curved grooves, *d*, as shown in Figure 4, the plates being placed at such a distance apart as to admit of said grooves being of a requisite width, and the sides of the plates *c* are beveled, as shown in Figure 1, so as to be parallel with each other, but inclined. The plates *c* may be attached to the bottom *b* of the pan in any proper way to secure them firmly in position and still admit of their ready removal when worn by use, to be replaced by new ones.

To the inner side of the pan A, just above the bottom *b*, there are attached a series of spiral strips, *e*. These strips are placed at equal and suitable distances apart, and extend entirely around the pan. D represents a muller, which is formed of a circular plate or disk, having a series of curved plates, *f*, attached to its under surface, to form curved grooves, *g*, precisely like the grooves *d* of the bottom *b* of the pan, but having a reverse position. The plates *f* are secured to the
62 muller in any proper way that will admit of a firm connection and their ready removal or detachment from the muller when worn out by use, so that they can be replaced by new ones. To the edge or periphery of the muller there are attached a series of spiral strips, *h*, which are similar to the strips *e*, but have a reverse position to them.

The muller D is attached by an universal joint, E, to a yoke, F, which is secured at its upper end to a shaft, G, said shaft passing down through an upright tube, H, which is attached to the center of the bottom *b* of the pan. The universal joint E is composed of a ring, *i*, which fits loosely on the tube H, and is provided at two opposite points with journals, *j*, which work in the lower end of the yoke F, and also provided at two opposite points with journals, *k k*, which work in bearings attached to the upper surface of the muller D. The lower end of the shaft G rests on a step, I, and directly over a lever, I′, and said shaft is rotated by bevel-gears, J, the driving-shaft K of which has its bearings

in the frame B of the machine. The universal joint E ensures the parallelism of the muller D and bottom *b* of the pan A. L represents a series of curved plates, four, more or less. These plates are se-
63 cured at their inner ends by screws or pins, *l*, and they each have a pin, *m*, projecting horizontally from them, and these pins are fitted into slides, *n*, which work in guides, *o*, attached to the inner side of the pan A. The inner ends of the plates L are secured by the screws or pins *l* between two annular plates, *p p*, the upper one of which has a frame, M, attached to it, through the top of which a screw, *g*, passes vertically, and rests on the upper end of the shaft G, as shown in Figure 1. The pan A is provided with a cover, N, as shown in Figure 1. The pulp is placed in the pan A with a necessary amount of quicksilver, and the muller D rotated through the medium of the gearing previously described; the grooves *g d* in the muller and bottom *b* of the pan causing the pulp to pass out to the edge of the muller, and the spiral strips *e h* forcing the pulp upward over the edge of the muller, while the curved plates L, which may be adjusted higher or lower by means of a screw *g*, have a tendency to contract *to* certifugal force*d* generated by the rotations of the muller, and cause the pulp to pass towards the center of the upper part of the muller and down through the eye or opening at the center of the same, to be again forced outward between the muller and the bottom *b*. The grooves *g d* form what may
64 be termed a draught, which gives a proper circulation or speed to the pulp, and admits of the same being operated upon by the muller repeatedly until all the metal contained in the pulp is amalgamated. The pan A is provided with a series of plugs or cocks to draw off, when necessary, the contents of the pan, and the steam-chamber underneath the pan A may have steam introduced into it in any proper way. The lever l′ admits of the muller D being raised when necessary, to admit of the ready starting of the muller.

Having thus described my invention, what I claim as new and desire to secure by letters-pattent is:

1st. The fixed spiral ribs *h* on the periphery of the rotary muller D, and reversedly spiral ribs *e* on the inner side of the pan A, in combination with the curved grooves *g* in the face or under side of the muller D, & reversedly curved in the bottom of the pan A when arranged for joint operation in the manner and for the purpose specified.

2d. Connecting the muller D to the shaft G by a universal joint composed of the yoke F and ring *i*, provided at four equi-distant points around its periphery with journals *j j*, *k k*, the former working in bearings in the lower end of the yoke F, and the latter in boxes attached to the upper side of the muller D, as and for the purpose specified.

65 3d. In combination with the muller D and pan A, the curved plates L, supported at their outer ends in slides, *n*, and at their inner ends in a frame, M, which is supported on the upper end of the shaft G in such a manner that the plates L will follow any adjustment of the muller, and thus bear the same relation to it, whether in its highest or lowest working position, as specified.

ZENAS WHEELER.

RD. W. HIGGINS,
OTIS V. SARVY,
Witnesses.

In the circuit court of the United States in and for the district of Nevada.

C. C. COOLIDGE
versus
F. BIRDSALL ET AL.

I, R. M. Daggett, clerk of the circuit court of the United States in and for the district of Nevada, hereby certify that the annexed and foregoing is a full, true, and correct copy of the original letters-patent attached to the complaint in said matter on file and of record in my office.

Witness my hand and the seal of said circuit court this 19th day of Nov., A. D. one thousand eight hundred and seventy-three, and of the Independence of the United States the ninety-eighth.

[SEAL.]

R. M. DAGGETT,
Clerk of said Court.
By T. J. EDWARDS,
Dep'y Clerk.

Exhibit A.

66 (Here follows diagram, marked page 66.)

The U. S. Patent-Office to all to whom these presents shall come greeting:

This is to certify that the annexed is a true copy, from the records of this Office, of the leters-patent granted, dated December 16th 1862, No. 37185, for "improvement in amalgamators for gold and silver."

In testimony whereof I, M. D. Leggett, Commissioner of Patents, have caused the seal of the Patent-Office to be hereunto affixed this eighteenth day of July, in the year of our Lord one thousand eight hundred and seventy-three, and of the Independence of the United States the ninety-eighth.

[SEAL.]

M. D. LEGGETT,
Commissioner.

No. 37185.

The United States of America to all to whom these letters-patent shall come:

Whereas Thomas Varney of San Francisco, California, has alleged that he has invented a new and useful improvement in amalgamators for gold and silver, which he states has not been known or used before his application; has made oath that he is a citizen of the United States, that he does verily believe that he is the original and first inventor or discoverer of the said improvement, and that the same hath not,
67 to the best of his knowledge and belief, been previously known or used; has paid into the Treasury of the United States the sum of thirty-five dollars, and presented a petition to the Commissioner of Patents signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose:

These are therefore to grant, according to law, to the said Thomas Varney, his heirs, administrators, or assigns, for the term of seventeen years from the sixteenth day of December, one thousand eight hundred and sixty two, the full and exclusive right and liberty of making, con-

structing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said Thomas Varney in the schedule hereunto annexed, and is made part of these presents.

In testimony whereof I have caused these letters to be made patent, and the seal of the Patent-Office has been hereunto affixed.

Given under my hand, at the city of Washington, this sixteenth day of December, in the year of our Lord one thousand eight hundred and sixty two, and of the Independence of the United States of America the eighty-seventh.

68 CALEB B. SMITH,
Secretary of the Interior.

Countersigned and sealed with the seal of the Patent-Office.
[SEAL.] D. P. HOLLOWAY,
Commissioner of Patents.

The schedule referred to in these letters-patent and making a part of the same.

To all whom it may concern:

Be it known that I, Thomas Varney, of San Francisco, in the county San Francisco, and State of California, have invented a new and improved amalgamating device, designed more especially for amalgamating silver; and I do hereby declare that the following is a full, clear, and exact description of the same, reference being had to the accompanying drawings making a part of this specification, in which Figure 1 is a vertical central section of my invention, x x, Figure 2, indicating the line of section. Figure 2, a horizontal section of the same, taken in the line of y y, Figure 1. Figure 3, a section of a portion of the same, taken in the line z z, Figure 2.

Similar letters of reference indicate corresponding parts in the several figures.

This invention consists in the employment or use of a rotary
69 and stationary muller, placed within a suitable pan or tub provided with a cover, and arranged in such a manner that when the device is in operation the ore will pass in a current or stream outward from the center, and between the mullers, to the circumference of the same, and thence inward, over the upper and rotating muller, to the center of the same, and down through said muller between, and the lower stationary one to be again thrown to the periphery of the mullers, thereby causing all the particles of the ore to be brought in contact with the quicksilver in the pan or tub, or with the amalgamated plates attached to the muller or mullers. The invention also consists in the employment or use of curved or spiral scrapers within the pan or tub, and arranged relatively with the upper surface of the rotating muller in such a manner as to ensure the passage or movement of all heavy substances in the pulp, thereby preventing the same from lodging on the rotary muller. To enable those skilled in the art to make and use my invention, I will proceed to describe its construction and operation with reference to the drawings. A represents a pan or
70 tub, which is placed on a suitable framing, B. This pan or tub is formed of two parts, *a b*, about of equal dimensions, and provided at their contiguous ends with flanges, *c*, through which bolts pass to secure the parts in contact. In order to prevent leakage, an India rubber or other suitable packing, *d*, is interposed between the flanges, as shown in Figure 1.

C is a vertical tube which is at the center of the lower part *b* of the pan or tub, and extends upwards some distance above the level of its upper edge. This tube C at its lower part is open, and communicates with the external air, in order that a shaft, D, may pass through it. This shaft D projects above the tube C, and upon it there is placed and keyed a tube, E, which fits over the tube C, and is allowed to turn or rotate freely upon it. To the lower end of this tube E there is attached a muller, F, which is a circular disk having slots, *e*, formed obliquely in its under surface, tangentially with a circular recess, *f*, at the center of the muller, at its under or face side. (See dotted lines in Figure 2.) At the center of the muller F, around the lower end of the tube E, there are openings, *g*, the use of which will be presently explained. Directly
71 underneath the muller F there is a stationary muller, G, which is formed of a circular plate having radial slots, *p*, made in it from its center to its periphery. These slots have an oblique position, and in one side of them there are fitted copper plates, *i*, as shown in Figure 3. At the center of the upper part *a* of the pan or tub there is an opening, *j*, through which the pulp passes. This opening is sufficiently large in diameter to admit of the tube E passing up through it, and still allow sufficient space for the pulp to pass into the pan or tub. H H are two vertical rods which pass through the upper part *a* of the pan or tub, and extend down a suitable distance within it. These rods have each a curved or spiral plate, I, attached to it. The shape of these plates is clearly shown in Figure 2. It will be seen that they extend from a ring, J, which encompasses the tube E to the periphery of the muller F. The shaft D is driven by gearing or other means below the pan or tub, and the lower end of said shaft is stepped in the framing B, as shown at K, in Figure 1. The operation is as follows: The pulp or crushed ore passes through the opening *j* into the pan or tub, which is supplied with a requisite quantity of quicksilver, the latter filling the slots in both
72 mullers, and the pulp extending above the upper muller F. The pulp passes down through the opening *g* at the center of the upper muller F, and by the rotation of the latter is forced out to the peripherys of the mullers, and passes over the upper surface of the upper muller F to the center of the same, and thence down through the opening *g*. Thus a constant circulation is kept up as indicated by the arrows in Figure 1, and all the particles of the ore or pulp brought in contact with the quicksilver and the silver amalgamated therewith. The curved or spiral plates I serve as scrapers and prevent heavy substances which may be contained in the pulp from resting or lodging on the upper surface of the muller F, ensuring the passage of the former along with the current. By having the pan or tub formed of two parts, as shown, a large quantity of ore or pulp is admitted into the pan or tub, and the amalgamating process is greatly expedited thereby.

The pan or tub A is provided with discharge openings, or tubes *i*.

I do not claim broadly a muller provided with slots or recesses and copper plates, for that has been previously used; but, having thus des-
73 cribed my invention, what I claim as new and desire to secure by letters-patent is—

1st. The employment or use of a rotating muller, F, provided with central openings, *g*, or arranged within a pan or tub, A, with a stationary muller, G, or an equivalent bed-plate, substantially as shown, to ensure a current or circulation of the pulp within the pan or tub, and between the mullers, and for the purpose set forth.

2d. A covered or close pan or tub, A, composed of two parts, *a b*, con-

nected together, when said pan or tub is used for an ore-amalgamating device, as specified.

3d. The curved plates or scrapers, I, arranged to operate in connection with the rotary muller, F, for the purpose herein set forth.

THOMAS VARNEY.

Witnesses:
ALFRED RIX.
C. MORRILL.
Ex'd. C. C. W.

(Here follows diagram, marked page 73.)

74, 75 In the circuit court of the United States in and for the district of Nevada.

COOLIDGE
versus
BIRDSALL ET AL.

I, R. M. Daggett, clerk of the circuit court of the United States in & for the district of Nevada, hereby certify that the annexed and foregoing is a full, true, and correct copy of the original letters-patent in said matter on file and of record in my office.

Witness my hand and the seal of the said circuit court this 9th day of Dec., A. D. one thousand eight hundred and seventy-three, and of the Independence of the United States the ninety-eighth.

[SEAL.]

R. M. DAGGETT,
Clerk of said Court.
By T. J. EDWARDS,
Dep. Clerk.

(Endorsed:) U. S. circuit court, ninth circuit, district of Nevada. C. C. Coolidge v. F. Birdsall et al. Bill of exceptions. Filed Jan'y 16, 1874. R. M. Daggett, clerk, by T. J. Edwards, dep. clerk.

76 In the circuit court of the United States for the district of Nevada.

C. C. COOLIDGE, PLFF.,
v.
F. BIRDSALL ET AL., DEFTS.

Let defts. in the above-entitled action have until and including the 20th day of January, A. D. 1874, to serve and file their bill of exceptions. It is ordered that execution in said action be stayed until and including the 9th day of March, A. D. 1874, or till otherwise ordered.

LORENZO SAWYER,
Circuit Judge.

SAN FRANCISCO, *Jan.* 9, '74.

(Endorsed:) In circuit ct. U. S., dist. Nevada. C. C. Coolidge v. F. Birdsall, et al. Order extending time to file bill exceptions and staying execution. Filed Jan'y 16, 1874. R. M. Daggett, clerk, by T. J. Edwards, dep. clerk.

In the Supreme Court of the United States of America.

F. BIRDSALL AND GEORGE F. LANGTRY, plaintiff in error,
v.
C. C. COOLIDGE, DEFENDANT IN ERROR.

77 Know all men by these presents, that we, F. Birdsall, as principal, and Newton Booth and C. T. Wheeler, as sureties, are held and firmly bound unto C. C. Coolidge in the penal sum of five hundred dollars, which we bind ourselves, our heirs and assigns, well and truly to pay, jointly and severally.

Nevertheless, the condition of the foregoing obligation is as follows: For that whereas the said C. C. Coolidge has obtained a judgment for damages and costs in the circuit court of the United States for the district of Nevada; and whereas the said Birdsall and Langtry are about to sue out a writ of error from the Supreme Court of the United States to correct alleged errors in said judgment:

Now, in case the said Birdsall and Langtry shall well and truly prosecute said writ and reverse said judgment, or otherwise pay to the defendant in error, C. C. Coolidge, all costs that may be awarded to him in said proceeding, and all costs accruing and due to the clerk or other officers of the court, then this bond to be null and void; otherwise to remain in full force and virtue.

78 Witness our hands and seals this thirteenth (13th) day of December, A. D. 1873.

F. BIRDSALL. [SEAL.]
NEWTON BOOTH. [SEAL.]
C. T. WHEELER. [SEAL.]

STATE OF CALIFORNIA,
County of Sacramento, ss:

Newton Booth and C. T. Wheeler, the sureties on the foregoing bond, being first duly sworn, depose and say, each for himself, and not one for the other, that they are worth double the sum named in the foregoing undertaking in property not exempt from execution, and over and above all their just debts and liabilities.

NEWTON BOOTH.
C. T. WHEELER.

Subscribed & sworn to before me this 13th day of Dec'r, A. D. 1873.
[L. S.] CYRUS S. COFFIN,
Notary Public.

(Endorsed:) In circuit court U. S., dist. of Nevada. F. Birdsall et al., plffs. in error, v. C. C. Coolidge, deft. in error. Bond on appeal. The within bond is hereby approved. Lorenzo Sawyer, circuit judge. Filed Dec. 15, 1873. R. M. Daggett, clerk, by T. J. Edwards, dep. clerk.

79 UNITED STATES OF AMERICA, *ss:*

The President of the United States of America to the judges of the circuit court of the United States for the district of Nevada, in the ninth judicial circuit, greeting:

Because in the record and proceedings, and also in the rendition of the judgment of a plea which is in the said circuit court before you, be-

tween F. Birdsall and George F. Langtry, plaintiffs in error, and C. C. Coolidge, defendant in error, a manifest error hath happened, to the great damage of the said plaintiffs in error, as by their complaint appears; and it being fit that the error, if any there hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, you are hereby commanded, if judgment be therein given, that then, under your seal, distinctly and openly, you send the record and proceeding aforesaid, with all things concerning the same, to the Supreme Court of the United States of America, together with this writ, so that you have the same at the city of Washington, in the District of Columbia, on the first Monday of October next, in the said
80 Supreme Court to be there and then held, that, the record and proceedings aforesaid be' inspected, the said court may cause further to be done therein to correct that error what of right and according to the law and custom of the United States should be done.

Witness the Hon. N. Clifford, senior associate justice of the Supreme Court of the United States, this first Monday of October, in the year of our Lord one thousand eight hundred and seventy-three, and of the Independence of the United States the ninety-eighth.

Attest:

[L. S.]

R. M. DAGGETT,
Clerk Circuit Court.
By THOS. J. EDWARDS,
Deputy Clerk.

The above writ of error is hereby allowed.

LORENZO SAWYER,
U. S. Circuit Judge, Ninth Judicial Circuit.

(Endorsed:) United States circuit court, district of Nevada. F. Birdsall et al., plffs. in error, v. C. C. Coolidge, deft. in error. Writ of error. Filed Dec. 15, 1873. R. M. Daggett, clerk, by T. J. Edwards, dep. clerk.

81 UNITED STATES OF AMERICA, *ss:*

To C. C. Coolidge, defendant in error, greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States of America to be held at the city of Washington, in the District of Columbia, on the second Monday of October, A. D. 1874, pursuant to a writ of error filed in the clerk's office of the circuit court of the United States for the district of Nevada, in the ninth judicial circuit, wherein F. Birdsall and George F. Langtry are plaintiffs in error and you are defendant in error, to show cause, if any there be, why the judgment in the said writ of error mentioned should not be corrected and speedy justice should not be done to the parties in that behalf.

Witness the honorable M. Clifford, senior associate justice of the United States Supreme Court, this 12th day of December, A. D. 1873, and of the Independence of the United States the ninety-eighth.

LORENZO SAWYER,
United States Circuit Judge, Ninth Jud'l Circuit.

(Endorsed:) United States circuit court, dist. of Nevada. F. Birdsall et al. vs. C. C. Coolidge. Citation. Filed Dec. 15, 1873. R. M. Daggett, clerk, by T. J. Edwards, dep. clerk.

82 Supreme Court of the United States.

C. C. COOLIDGE, DEFENDANT IN ERROR,
v.
F. BIRDSALL & GEORGE F. LANGTRY, PLAINTIFFS IN ERROR.

DISTRICT OF NEVADA, *ss:*

James F. Lewis, being duly sworn, deposes and says that, on the eighteenth day of December, A. D. 1873, at the city of Virginia, in the State of Nevada, he served on the above-named defendant in error a copy of the citation filed in this cause in the office of the clerk of the circuit court of the ninth circuit for the district of Nevada, by delivering a copy thereof to Messrs. Williams & Bixler, his attorneys in said cause, and also at the same time notified the said attorneys that a copy of the writ of error therein was lodged for said defendant in error with the clerk of said circuit court.

JAMES F. LEWIS.

Subscribed and sworn to before me this 25th day of June, A. D. 1874.

R. M. DAGGETT,
Clerk Circuit Court, Dist. of Nevada.
By T. J. EDWARDS,
Dep. Clerk.

83 (Endorsed:) Supreme Court of the United States. C. C. Coolidge v. F. Birdsall and George F. Langtry. Affidavit of service of citation. Filed June 25, 1874. R. M. Daggett, clerk cir. court, dist. Nevada, by T. J. Edwards, dep. clerk.

Supreme Court of the United States.

C. C. COOLIDGE, PLAINTIFF,
v.
FREDERICK BIRDSALL AND GEORGE F. LANGTRY, DEFENDANTS.

Know all men by these presents, that we, A. M. Edgington and A. J. Tyrrell, of Virginia City, State of Nevada, are held and firmly bound unto C. C. Coolidge, of the city of San Francisco, State of California, in the sum of twenty-five hundred dollars, to be paid to the said Coolidge, his executors and administrators; to which payment, well and truly to be made, we bind ourselves and each of us, jointly and severally, and our and each of our heirs, executors, and administrators, firmly by these presents, sealed with our seals and dated this 30th day of December, A. D. 1873.

Whereas the above-named defendants, Frederick Birdsall and
84 George F. Langtry, have presented a writ of error to the Supreme Court of the United States to reverse the judgment rendered in the above-entitled action against them by the circuit court of the United States for the district of Nevada on the fifth day of December, A. D. 1873:

Now, therefore, the condition of this obligation is such that if the above-named Frederick Birdsall and George F. Langtry shall prosecute

their said writ of *of* error to effect, and answer all costs and damages if they shall fail to make good their plea, then this obligation shall be void; otherwise to remain in full force and virtue.

GEO. F. LANGTRY. [L. S.]
A. M. EDGINGTON. [L. S.]
A. J. TYRRELL. [L. S.]

Sealed and delivered in presence of—
A. J. RALSTON.
R. M. DAGGETT.

STATE OF NEVADA,
County of Storey, ss:

A. M. Edgington and A. J. Tyrrell, being duly sworn, each for himself, and not one for the other, deposes and says that he is a resident and freeholder in said county of Storey, and that he is worth the sum of twenty-five hundred dollars over and above all his debts, and
85 exclusive of property exempt from execution.

A. M. EDGINGTON. [L. S.]
A. J. TYRRELL. [L. S.]

Subscribed and sworn to before me this 30th day of Dec., A. D. 1873.
R. M. DAGGETT,
Clerk U. S. Circuit Court, Dist. of Nevada.

(Endorsed:) In Supreme Court of the United States. C. C. Coolidge v. Frederick Birdsall and George F. Langtry. Bond on writ of error. Approved, E. W. Hillyer, judge. Jan. 30, 1874. Filed Jan'y 30, 1874. R. M. Daggett, clerk cir. ct., dist. Nevada, by T. J. Edwards, dep. clerk.

86 UNITED STATES OF AMERICA,
District of Nevada, ss:

I, R. M. Daggett, clerk of the circuit court of the United States for the district of Nevada, do hereby certify that the foregoing transcript contains a full, true, and correct copy of the following papers, now of record in my office, in the cause of C. C. Coolidge against F. Birdsall et al., to wit: Complaint, answer, 2 notices of special matter, verdict, judgment, bill of exceptions, 2 bonds on appeal, order extending time to file bill of exceptions, writ of error, citation, and affidavit of service of citation.

In witness whereof I have hereunto set my hand and affixed the seal of said circuit court, at my office in Carson City, in said district of Nevada, on this 14th day of July, A. D. 1874.

[SEAL.] R. M. DAGGETT, *Clerk.*
By THOS. J. EDWARDS,
Dep. Clerk.

(Indorsement on cover:) No. 236. Frederick Birdsall and George F. Langtry, plaintiffs in error, vs. C. C. Coolidge. Nevada C. C. U. S. Filed 3rd September, 1874.

Supreme Court of the United States.

F. BIRDSALL and GEORGE T. LANGTRY,

Plaintiffs in Error,

vs.

C. C. COOLIDGE,

Defendant in Error.

BRIEF FOR PLAINTIFFS IN ERROR.

BEATTY & DENSON,
LEWIS & DEAL,
For Plaintiffs in Error.

M'GILL & WITHEROW, PRINTERS AND STEREOTYPERS, WASHINGTON, D. C.

Supreme Court of the United States.

F. Birdsall and George T. Langtry,
Plaintiffs in Error,

vs.

C. C. Coolidge, Defendant in Error.

Brief for Plaintiff's in Error.

I.

The questions involved in this case are—

1st. Whether the curved plates used by the plaintiffs in error are patented to the patentee by themselves, or in combination with the particular kind of pan and muller described in the specifications.

2d. Whether, under the proofs, the plaintiff was entitled to any damage at all; or, if entitled to any, whether he could, under the complaint, recover more than two thousand dollars.

3d. Whether the court did not err in giving certain instructions to the jury, and in refusing others asked by the plaintiffs in error; all of which will appear in the assignment of errors.

II.

The action was brought in the circuit court of the United States for the ninth circuit in and for the district of Nevada, by C. C. Coolidge, legatee of Zenas Wheeler, deceased, to recover from the plaintiffs in error damages for having used certain improvements in amalgamating pans claimed by the defendant in error to have been invented by and pat-

ented to Wheeler by letters patent issued to him on the 8th day of November, A. D. 1863.

Nothing in the patent need be considered except that portion of the specification in which the muller and pan are described, together with the claim by the patentee of what he desired to be patented.

The muller and pan are thus described in the specification:

"A represents a pan, which may be about four feet in diameter and about twenty-two inches in depth. This pan stands upon a frame, B, which may be of iron, and provided with a horizontal iron top plate, C, having a circular depression or recess, *a*, over which the pan is placed, said depression or recess forming a steam chamber, by which the pan is heated in order to favor amalgamation. The pan may be constructed of wood, provided with an iron bottom, or it may be entirely of iron. The bottom of the pan, which is designated by *b*, has a series of curved plates, *c*, attached to its upper surface.

"These plates, *c*, are of such a shape that they form curved grooves, *d*, as shown in Figure 4, the plates being placed at such a distance apart as to admit of said grooves being of a requisite width, and the sides of the plates *c* are beveled, as shown in Figure 1, so as to be parallel with each other, but inclined. The plates *c* may be attached to the bottom, *C*, of the pan in any proper way to secure them firmly in position, and still admit of their ready removal when worn by use, to be replaced by new ones.

"To the inner side of the pan *a*, just above the bottom, *C*, there are attached a series of spiral strips, *e*. These strips are placed at equal and suitable distances apart, and extend entirely around the pan. D represents a muller, which is formed of a circular plate or disk, having a series of curved plates, *f*, attached to its under surface to form curved grooves, *g*, precisely like the grooves *d*, of the bottom, *C*, of the pan, but having a reverse position.

"The plates *f* are secured to the muller in any proper way that will admit of a firm connection and their ready removal or detachment from the muller when worn out by use, so that they can be replaced by new ones. To the edge or periphery of the muller there are attached a series of spiral strips, *h*, which are similar to the strips *e*, but have a reverse position to them."

And the patentee thus designates what he claimed to be new and desired patented, to wit:

"Having thus described my invention, what I claim as new and desire to secure by letters patent, is—

"1st. The fixed spiral ribs *h*, on the periphery of the rotary muller D, and reversed spiral ribs I, in the inner side of the pan *a*, in combination with the curved grooves *g*, in the face or under side of the muller D, and reversedly curved grooves *b*, in the bottom of the pan *a*, when arranged for joint operation in the manner and for the purpose specified.

"2d. Connecting the muller D to the shaft by a universal joint composed of yoke F and ring I, provided at four equi-distant points around its periphery with journals, *g g*, *h h*, the former working in bearings in the lower end of the yoke F, and the latter in boxes attached to the upper side of the muller D, as and for the purpose specified.

"3d. In combination with the muller D, and pan *a*, the curved plates L, supported at their outer ends in slides N, and at their inner ends in a frame M, which is supported on the upper end of shaft G, in such a manner that the plates L will follow any adjustment of the muller, and thus bear the same relation to it, whether in its highest or lowest working position, as specified."

The answer filed consists of—

1st. The general issue.

2d. The sale to the defendants of twenty pans by the assignee of Wheeler, and that they had a right to continue to use that number of the Wheeler pan.

3d. That Wheeler had not marked his pans, or the improvements claimed to have been invented by him, "patented," as required by statute; and that the defendants were ignorant of the fact that they were patented. Further, that what Wheeler claimed to have patented had been openly and universally used by the public from the time of his alleged invention to the present time, without objection on the part of Wheeler; and if he ever acquired any right therein, he had thus abandoned it.

On the trial of the case, the plaintiff (defendant in error) admitted that of the three specifications in Wheeler's patent, the first and second had not been infringed by the defend-

ants. The complaint was for having infringed by the use of the third, namely, the "curved plates." (See page of transcript.)

One of the first and most important questions that arose in the progress of the trial was, as to whether the curved plates or "wings," alleged to have been used by the defendants, were not patented by Wheeler as a part of a combination. That question was raised by means of an instruction asked by the defendants, which was, however, refused by the learned judge in the court below.

The next question of importance raised involved the measure of damage. It will be observed that the plaintiff only claims to have been damaged in the sum of two thousand dollars. It is true the court is asked to treble the actual damage so alleged to have been suffered, in accordance with the statute.

But the actual damage which it is alleged was occasioned the plaintiff by the infringement is two thousand dollars, or one hundred dollars for each pan used by the defendants containing his patented improvements.

But under the instruction of the court, the jury found a verdict in the sum of twenty-two hundred dollars, although it was clearly shown that only sixteen of the pans, upon which no royalty had been paid, were used by defendants. To render the various points raised on the question of damage intelligible to the court, and to show how they were raised, it will be necessary to narrate some facts showing the manner in which the defendants became connected with and continued the use of the Wheeler pans.

In the year 1863, as alleged in the answer, (the evidence in the bill of exceptions not showing the exact date,) F. Birdsall & Co. bought twenty "improved Wheeler pans" of H. J. Booth & Co., of San Francisco, who were manufacturing them under an arrangement with the patentee, Wheeler, from whom Coolidge, the plaintiff, claims.

Hereafter the pans thus purchased may be called the pans of 1863, to distinguish them from those of 1869.

On the pans of 1863 a royalty of one hundred dollars per pan was paid to Zenas Wheeler. They were taken to Nevada, and put up and worked in the mill of F. Birdsall & Co.

But these pans were in no manner marked patented, although there would have been no difficulty in so marking them. (See Transcript, p. ; Bill of Exceptions, p. 6.)

Subsequently—that is, in 1869—F. Birdsall & Co. (then consisting of F. Birdsall and George F. Langtry, the defendants) purchased thirteen pans from John McCone and seven from one C. L. Greely. These pans were similar in general pattern to those purchased by Birdsall & Co., in 1863, from Booth & Co. Whilst these pans purchased by McCone and Greely were being put in place, in the month of September, A. D. 1869, Coolidge, the plaintiff, testified that, acting as the agent of Wheeler, (who, however, it appears, had died in Australia before that time,) he notified Langtry that he was infringing Wheeler's patent by the use of the pans then being put up. Langtry, however, went on and put up pans in position, and in sixteen of them for a short time used the wings which were purchased in connection with them. But they were found to be useless for the purpose for which they were intended. In the other four pans they were not used at all. (See page Transcript; pp. of Bill of Exceptions.)

Although McCone, Greely, Langtry, and Birdsall appear to have known that Wheeler had a patent for improved amalgamating machine, yet neither of them seemed to know in what that improvement consisted; and it would seem Wheeler himself was not very certain.

Both Birdsall and Langtry swear that they did not know what Wheeler claimed to have patented, and this testimony is uncontradicted.

It was also proved that Greely and McCone, the manufacturers, inquired of Wheeler as to whether the pans they were manufacturing (the same as those sold by them

to defendants in 1869) were an infringement of his patent, and he assured they were not, and that they might continue to manufacture the same without infringement of his right. (See page of Transcript.)

With this general statement of the case we now pass to an assignment of the errors upon which we rely for a reversal of the judgment in the court below.

ASSIGNMENT OF ERRORS.

First. The action being for the infringement of a combination, namely, the curved plates, in connection with a particular character of pan and muller, and the plaintiff failing to show the use of that combination, the court erred in refusing the following instruction:

"The Wheeler patent here introduced in evidence, so far as this case is concerned, is for a combination of the curved plates and the pan and muller *described in the specifications* and patent. As there is no proof that wings or curved plates were ever used in connection with the pan and muller *described*, you must find for the defendant."

Second. The court below erred in refusing to allow an answer to the following question propounded to the defendant, Birdsall, to wit: "With regard to these wings that were sent them with the Greely and McCone pans, did you consider them of sufficient value to have retained them, if you had known there was a claim of patent upon them?"

Third. The court erred in giving the following instructions:

"There is testimony given here by the various witnesses as to whether it was or not useful. That testimony you must consider; and I will say in regard to it that the testimony that they have gone extensively into use is testimony tending strongly to prove their usefulness. Testimony that it has been bought and used is evidence of its usefulness, because people are not generally in the habit of buying things, and using them, which they do not deem useful.

"If there was any other thing before known, or any

other thing not patented, that would produce the same results, parties are at liberty to use them, and need not pay a royalty upon a patent if they have got a patent which they can use to accomplish that same purpose. And the very fact that they do purchase and use a patented instrument is evidence of itself tending to show that it is useful; but whether it is sufficient or not is a question for the jury to determine."

After this instruction was given in this form, and the defendants (plaintiffs in error) had excepted to it, the court qualified the same by adding as follows:

"I say it is a circumstance which they are entitled to consider in reference to the other testimony on the subject, if you except to it in that form. I say these facts are facts for the jury to consider, and give them such weight, in connection with the other testimony, as they think they are entitled to."

Fourth. The court erred in giving the following instruction:

"I had some doubt on the rule of damages on the argument of this case, but upon the whole I do not see any other way than to adopt the ordinary rule in such cases, when the royalty has been established, and make the royalty the measure of damage. I do not see that any other rule in reference to this particular class of cases, where a person, without leave or license, appropriated the plaintiff's invention, although he afterwards abandoned it. If, then, you find any damages, the damages will be the royalty which he obtained for this particular part of his invention. If a royalty of one hundred dollars was paid for this invention, then there would be one hundred dollars on each pan so used, and interest upon that sum at the rate of interest in this State, ten per cent. per annum, from date of the appropriation, say from the first of October, A. D. 1869."

Fifth. The court erred in giving the following instruction:

"The court further instructs the jury, that if they find that the plaintiff's patent covered a new and useful invention, and it had been infringed by defendants, they may find for the plaintiff, although they do not find any damages for him."

Sixth. And further, with reference to damages, the court

read to the jury the statute requiring all articles made or vended by any party under the protection of a patent to be stamped or labeled with the word "patented," and date of the patent, and providing that on failure to so stamp or label the article, in an action for infringement of the patent by the party failing so to mark the article, the right to which is infringed, no damage shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued after such notice to make or vend the article patented, and then, in relation to said provisions, charged the jury as follows:

"I instruct you, gentlemen, that it is sufficient if the patentee stamped the word "patented," and the date of the patent, in any reasonably conspicuous place on the completed pan. It is not necessary to put it on each part covered by a distinct claim; but if it was stamped in any reasonably conspicuous place upon the completed patented article, then the plaintiff is entitled to recover his damages."

Seventh. The court erred in giving the following instruction:

"There is testimony here by the plaintiff that, before these pans were started, and while they were being put up, he had a conversation with one of the defendants, Mr. Langtry, about the payment of the royalty upon these very pans, indicating to the defendants that there was a patent upon those pans, which he was infringing if he used them, and calling for the royalty. He testified that he said he was going to Idaho at the time, and would return in a few weeks, and that Langtry said he would consult with his partner about it, and let him (Coolidge) know when he came back.

"Langtry, on the other hand, testifies that he has no recollection of any such conversation. He said there was no such conversation took place. This is a question for you to determine between them. If Langtry had that notice, that would be sufficient under this statute to bring notice home to him. If he was informed that there was a patent on them (these pans) that was *sufficient to put him upon inquiry, and he was bound to pursue it* and see what particular part of that machine it covered; so that, if they had actual notice in either of these models, if it was such as to

satisfy you that they had notice of the existence of this patent, or notice of such *facts as made it obligatory upon them to ascertain the exact facts, it is sufficient for this purpose;* and if they had received this notice and there was a violation of this patent, the plaintiff is entitled to damages."

Eighth. The court erred in giving the following instruction:

"If the defendants had notice of this patent, and there was an infringement by them after such notice, although the pans purchased from Booth & Co. were not stamped, still the plaintiff is entitled to recover damages."

Ninth. The court erred in refusing to give the following instructions, which were asked to be given by defendants below:

"If the jury believe from the evidence that John McCone exhibited to Zenas Wheeler, in the month of October, 1868, a finished pan precisely like the thirteen pans that he furnished to Birdsall & Co., the defendants, in the year 1869, and asked said Wheeler if the making of these pans was an infringement of his patent, and the said Wheeler, with a full knowledge of the fact that the wings described in the first instruction asked for by defendant, and substantially the same as the short wings in the brass model shown to the jury, were a part of, and ready made and fitted to be attached to said pans, told the said McCone that such pans so manufactured were not an infringement on his patent, then the defendants, as vendees of said McCone, are protected, as to the thirteen pans sold to them by McCone, and no recovery can be had against them on account of using the wings in the McCone pan.

"If the jury believe from the evidence that in the year 1867 A. L. Greely was manufacturing pans precisely similar to the seven pans which he furnished the defendants in 1869, in all respects, except that the pans furnished defendants were larger than those manufactured in 1867, and that Zenas Wheeler, in the aforesaid year 1867, called on said Greely to ascertain in what particular the said Greely was violating his patent, or manufacturing articles on which he claimed a royalty, and the said Wheeler knew that the pans then being manufactured were to contain wings on the inner periphery of the pan, similar to the short wings on the brass model now before the jury, and did settle with

the said Wheeler for all the royalty by him claimed, and did at the same time inform the said Greely that the pan thus manufactured by Greely was not a violation of his (Wheeler's) patent, and the said Greely, relying on said declaration, did continue to manufacture and sell such pans with the wings, then the defendants are not liable for having used the wings in the pans furnished by Greely in the year 1869."

ARGUMENT.

I.

Under the first error assigned, we assume that there is no question but that the court must come to the conclusion that the wings or curved plates are patented only as a part of a combination; that is, that the thing covered by the patent is the machine made up of the wings, together with the pans and muller described in the specifications; for it is so claimed, as will be seen by the third claim made by the patentee, to wit: "In combination with the muller D, and pan A, the curved plates L, supported at their outer ends in slides, *n*, and at their inner ends in a frame, M, which is supported on the upper end of the shaft G, in such a manner that the plates L will follow any adjustment of the muller, and thus bear the same relation to it, whether in its highest or lowest working position, as specified." The only point, then, upon which there can be any doubt arises upon the question as to what constitutes the pan and muller, in combination with which the curved plates were patented; that is, whether the things attached to the inside of the pan and outside of the muller, and called "spiral ribs" in the specifications, constitute a part of the pan and muller.

If the patentee has by his specifications made those things a part of the pan or muller, or rather, if his patent simply covers the curved plates when used in combination with a pan and muller, having the spiral ribs; then there is no question but the learned judge at the circuit erred in refusing the instruction quoted in the first assignment of

error, for it was proven, and that without contradiction that neither the pans nor the mullers with which the defendants used the curved plates were constructed with the "spiral ribs;" they were not, therefore, the pans and mullers described in the specifications, and, as a consequence, it cannot be said that the plaintiffs in error infringed the patent, for they did not use the machine or combination as patented, but only a part of it, namely, the curved plates or wings, which, under all the decided cases in this country, does not constitute an infringement.

It only remains, then, to be determined whether the "spiral ribs" were of necessity a part of the pans and mullers mentioned in the specifications.

We claim that the patentee has described the particular kind of pan and muller which are to constitute a part of his combination; that is, pans and mullers having the "spiral ribs" on their peripheries. The court will see from the quotations already made from the specifications, that the patentee minutely describes a pan and muller, and mentions, among other things, the spiral ribs on the periphery of each as a part of the pan and muller in this manner: "To the inner side of the pan A, just above the bottom *b*, there are attached a series of spiral ribs *e*. These strips are placed at equal and suitable distances apart, and extend entirely around the pan. D represents a muller, which is formed of a circular plate or disk, having a series of curved plates S attached to its under surface, to form curved grooves *g*, precisely like the grooves *d* of the bottom *b* of the pan, but having a reverse position. The plates F are secured to the muller in any proper way that will admit of a firm connection, and their ready removal or detachment from the muller when worn out by use. To the edge or periphery of the muller there are attached a series of spiral strips *h*, which are similar to the strips *e*, but have a reverse position to them."

Here, it will be seen, the spiral strips are specified as a part of the muller and pan so clearly that without them they could not be called the muller or pan described in the

specifications, because of the absence of an essential part of them.

Surely it will not be claimed that the patentee could claim a violation of his patent, in a case where the curved plates were used in combination with a pan or muller essentially different from the one described in his specifications, because the thing patented by him is not the curved plates, in combination with any and all kinds of pans or mullers, but rather with a pan and muller, substantially like the one described by him.

The thing which he claims to be new, and for which he asks a patent, is a combination of things minutely described, namely, the pan A and muller D, together with the curved plates. Now, the pan A and muller D certainly does mean any character of pan or muller that may be used for amalgamating ores, but the pan and muller described and designated as A and D in the specifications. Suppose, instead of claiming the patent for the curved plates in combination with the pan and muller, which he designates as pan A and muller D, he had made the claim for a combination of the plates, with a muller and pan, minutely describing them. Certainly it cannot be said that in such a case there could be an infringement of the patent, by the use of the plates in combination with a pan and muller materially differing from the ones so described; and yet that is really this case, because, to designate the pan which is to form a part of the combination as pan A, and the muller as D, when the pan and muller so designated have already been minutely described, is the same as if the patentee had in his claim again described them.

Can it be said, then, that a muller and pan, not having the "spiral ribs" described in the specification, and no equivalent therefor, are substantially the muller and pan described by the patentee as a part of his combination? He describes the ribs, how they are attached to the pan, and the office which they are to perform; also describes other portions of the pan and muller, and finally desig-

nates the machine having the spiral ribs attached as pan A and muller D.

Now, upon what rule of construing language can it be said that the ribs are not a part of the pan? We think that, upon a fair construction of the patent, it must be held that the spiral ribs are made a part of the muller. Whether they are a material part of the muller or not need not be discussed here, because they are made so by the patentee claiming a patent for them. (See Vance *v.* Campbell, 1 Black., 427.) If they be a part of the muller, we conclude that there is no infringement, except where the curved plates are used in connection with a muller and pan having such ribs, and the instruction should therefore have been given.

II.

With regard to the second assignment of error, we claim it to be a legal axiom, as applicable in cases of this kind as in others, that if it appears on the trial of an action on the case for damages, that the act complained of as being done by the defendant could not have occasioned any actual injury to the plaintiff, and was no benefit to the defendant, then, although the act was technically a violation of plaintiff's rights, there can be nothing more than nominal damages recovered.

More especially would this be the case if the act of the defendant was free from all suspicion of willful or intentional wrong.

When damages are recovered from one who merely uses a patented article in contradistinction to one who manufactures and sells such articles, the measure of damages is the customary price of the royalty, with interest; and this rule is doubtless founded on the very rational conclusion that, if the defendant had not pirated the article, he would have paid the royalty; that in consequence of the piracy the plaintiff lost the sale of the article and the royalty, and the defendant made the same profit that he would have made if he had paid the plaintiff the ordinary price of his royalty.

But in this case it appears (if not conclusively, yet so strongly that the matter should have been submitted to the jury) that the defendants below did not know they were buying a patented article. (See page ——, Transcript.)

It further appears that the only part of the thing purchased by them, which was covered by Wheeler's patent, was a movable wing, loosely attached to the inner surface of the periphery of the pan, and easily removable. (See page ——, Transcript.)

That this movable wing was of no benefit whatever to the pan or amalgamator, when used for the purpose for which they were intended. (See page —— of Transcript.)

Now, if the defendants had been allowed to prove, in addition to these facts, that Birdsall and his partner looked on these wings as of so little value that they would not have retained them if they had known they were subject to a claim for royalty, would not the defense have been complete, so far as any real damage was concerned?"

The facts would have shown—

1st. That the thing used was not marked "patented."

2d. That Birdsall & Co. did not know the wings were patented.

3d. The wings were easily removed without affecting the usefulness of the remainder of the pans, muller, etc.

4th. That the wings were not a benefit, but an incumbrance in the pans.

5. That if Birdsall & Co. had known they were protected by patent, they would not have used them, and therefore Wheeler could not have lost a royalty.

Was it not, then, essential that we should prove this last point? And if proved, would it not have precluded the possibility of more than nominal damages? We think the refusal to allow this proof was error.

Upon the general proposition that the royalty in such cases is not always the proper measure of damage, we refer to the case of Seymour *v.* McCormick, 16 How. 480.

The court, when speaking of the royalty as the measure of damages, use this language:

"There may be cases, as when the thing has been used for a short time, in which the jury should find less than that sum." (Top page, 490.)

So, too, in the case of The Suffolk Company *v.* Hayden, 3 Wallace, 315, the court use this language:

"It is proper to say, as was said in the court below, that the jury, in ascertaining the damages upon this evidence, is not to estimate them for the whole term of the patent, but only for the period of the infringement. A recovery does nor vest the infringer with the right to continue the use, as the consequence of it may be an injunction restraining the defendant from the further use of it. (Page 320.)

Here the thing was only used for a short time. It was of no benefit to those who used it, and had we not a right to show that it was no injury to the patentee, so as to take the case out of the general rule that the royalty is the measure of damage?

III.

As to the third assignment of errors, we have no authority to cite, but submit that, as a reasonable conclusion, the mere purchase and use of an article does not prove its usefulness, especially so when the purchaser has had no experience with the article. The plausible representations of vendors of patented articles may, and frequently do, induce parties to purchase articles which, on trial, turn out to be utterly worthless.

The mere fact, then, that articles of a class have frequently been purchased or used should not be received as evidence of usefulness, unless it was also shown that such purchasers had seen the articles tested before the purchase, or had some other means of knowledge as to its utility. Particularly was such testimony utterly inapplicable to a case of this kind, when the thing patented (the curved plates) bears so small and insignificant proportion to the whole machine. If one were purchasing an amalgamating pan, with all its heavy castings, its shoes and dies, muller, cog-wheels, gearing, etc., he would not be likely to decline

the purchase of one otherwise suitable in size, workmanship, etc., simply because there was in it a wing which might be considered worthless—a wing which could be removed in a moment, and which, under any circumstances, could have added but a trifle to the whole cost of the pan, and its accompanying muller, shoes, dies, cog-wheels, and other connections. We insist the court gave undue prominence to the fact that Wheeler had sold many of his improved pans, and thereby misled the jury.

IV.

As to the fourth assignment of errors, we will say that the instruction seems wrong in several particulars. We refer to our argument and authorities on the second assignment of errors, in support of the proposition that the plaintiff's patent right, having been violated only for a very short time, and then voluntarily abandoned, the defendants in the court below having derived no benefit whatever from it, and there being a total absence of proof that plaintiff was deprived of any sale of the patented article by means of such use, the entire royalty, one hundred dollars, was not the proper measure of damage.

See 16 Howard, 490.
3 Wallace, 320.

The instruction was further clearly wrong in directing the jury to give as damages one hundred dollars on each pan used, and *interest* at the rate of ten per cent. per annum from the 1st of October, A. D. 1869.

We do not question the correctness of the proposition that interest is one of the elements which may, *under proper* circumstances, enter into the calculation in determining the amount of damages which a plaintiff may recover. But we do not understand that a plaintiff may, under any circumstances, recover more damages than he alleges he has suffered. The plaintiff below in this case alleges the unlawful use of twenty of his pans, and a damage sustained thereby of two thousand dollars; or, in other words, dam-

ages to the amount of one hundred dollars on each pan used.

It was also in proof that the royalty was one hundred dollars a pan. Now, the plaintiff might have asked for damages in the sum of one hundred dollars, and interest from the time his rights were infringed, on each pan pirated; but he did not. He only alleges damages in the aggregate of two thousand dollars. It is true he asked the court to treble his damages under the statute. That, however, has nothing to do with the damages alleged or actually suffered, which constitute the basis of the allegations of his pleading. We are now dealing with the damages only as found by the jury. We cannot see how the plaintiff, who only alleges damages to the amount of two thousand dollars, on twenty machines, can recover over twenty-two hundred dollars, when he proves the use of only sixteen pans. The pleader who alleges damages in gross is supposed to allege *all* the damages his client has sustained. If the injury was done a long time before the pleading is filed, of course the time plaintiff has been compelled to wait for redress constitutes a part of his damages in ordinary cases; and the pleader must frame his declaration to cover that loss, else he cannot recover.

But in patent cases it is doubtful, even if under a declaration properly framed; and when the amount demanded is sufficient to cover the royalty, and interest from the date of the piracy, the jury would be authorized to give a verdict for interest. Under the patent law the jury are confined in their verdict to actual damages sustained by the patentee by reason of the piracy. Now, it appears to us rather doubtful if one can include interest in the term actual damage sustained by the wrongful act. Is not this matter of interest something to be considered by the court in determining what percentage shall be added to the verdict of the jury in the way of punitive damage?

In any case, we think it impossible that there can be any rule of law that will allow the plaintiff below to recover a

verdict at the hands of a jury for a larger amount than he demands in his complaint.

V.

The fifth exception cuts no figure in this case as it now stands. It can only be important for this court to notice it in the event the case goes back for further trial. We do not think that, in a simple case of an action on the case for damages, the plaintiff can be entitled to recover costs if he is not entitled to recover any damages. If the defendants violated plaintiff's patent, but still are not liable in damages, it must be on the ground that plaintiff failed to do what the patent law required of him: to give notice of his invention.

If, then, the plaintiff was first in fault, we do not think the defendants should be made to pay the costs of a litigation which arose from the fault of the other side, and that when the law expressly says he shall not be subjected to damages.

VI.

The sixth assignment of error, like the fifth, is only important in the event of another trial of this case, in which event it might be of the greatest consequence to know what rule to follow.

It will be observed (see page ——, Transcript) that Wheeler does not claim to have invented a pan, or a muller, or any of the gearing by which the muller is put in motion. His invention consists in three things:

First. "Spiral ribs" in combination with curved grooves in the bottom of the pan and muller, afterwards abandoned, and not involved in this controversy.

Second. The manner of connecting the muller with the shaft by an universal joint.

Third. The curved plates in combination with the muller D and pan A.

What we claim is this, that the word "patented," marked on a pan for which no patent was ever sought or

obtained, would not be notice that some particular part of the pan only was patented. It would naturally tend to mislead parties rather than give them information.

After the spiral ribs and curved grooves and universal joint were discarded in the manufacture of the Wheeler pan, then nothing of the patent remained but the curved plates. It was perfectly practicable to stamp or mark on each of these curved plates the word "patented," and the date of Wheeler's patent. If that had been done, the probability is Birdsall & Co. would never have used them.

We contend it was sufficient for defendants below to prove that Wheeler had sold these wings or plates and put them in common use without being marked patented, when it was perfectly practicable to have so marked them. But in this case the defendants proved more; they proved that, at least, if Wheeler himself did not sell, that he permitted others to manufacture and sell, he receiving the royalty, (see Transcript, page ——,) without marking or imprinting the word patent on any part of the machine.

VII.

The first question presented under the seventh assignment of errors is this: If Wheeler sold his patented machine to Birdsall & Co., and put it in use in Lyon county, Nevada, where Birdsall's mill was situated, in 1863, without any mark on it to indicate it was patented, could he recover damages against Birdsall & Co. for using others of the same kind, purchased from other manufacturers in 1869?

On this point we think there is little opportunity for difference of opinion. The instruction set forth in the seventh assignment of errors is in the very teeth of the statute.

It will be borne in mind that Birdsall & Co. bought of H. J. Booth & Co., in 1863, twenty improved Wheeler pans, to be used in the mill at Layton, Lyon county, Nevada. (See Transcript, page ——.) Booth & Co. made and sold these pans by the permission of Wheeler, and paid him a royalty for the same. (See page —— of Transcript.)

In 1869 Birdsall and Langtry bought of McCone thirteen pans, and of Greely seven, precisely like those Birdsall & Co. bought of Booth & Co. in 1863, and to be used in the same mill. These latter pans were part of them put in use about the first of September, and within six weeks from that time (certainly before the month of November) all the wings were discarded, and never afterwards used. (See page —— of Transcript.)

Now, during the entire year A. D. 1869, and up to July 8th, 1870, the following section of an act passed March 2d, 1861, was in force, to wit:

"In all cases where an article is made or vended by any person under the protection of letters patent, it shall be the duty of such person to give sufficient notice to the public that said article is so patented, either by fixing thereon the word patented, together with the day and year the patent was granted, or, when from the character of the article patented that may be impracticable, by enveloping one or more of the said articles and affixing a label to the packages, or otherwise attaching thereto a label in which the notice with the date is printed; on failure of which, in any suit for the infringement of letters patent by the party failing so to make the article, the right to which is infringed upon, no damage shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, *to make and vend the articles patented.*

"And the sixth section of the act entitled an act in addition to an act to promote the progress of the useful arts, &c., approved the 29th day of August, A. D. 1842, (c,) be, and the same is hereby repealed."

Now, the rational construction of this act certainly is that, if the patented article be sold or put on the market with the assent of the patentee, he can afterwards recover no damages for a violation of his patent, except from those who continue to *make or vend* the same after being duly notified. But the defendants below did not make or vend the Wheeler pan or curved plates. They only used pans that were made and vended by others. It will not do to say that although the law only mentions those who make

and vend, still the reason of the rule extends to all who use, and therefore the exception shall be extended by implication to them. The reason of the rule does not apply with equal force to the one who uses an article as to the maker. If one is notified that he is violating a patent right by manufacturing a certain machine, he may well be required to cease such manufacture. But if one purchases a machine from one who has at the time of the transaction the right to make and vend such machine, (whether that right arises from the negligence of the patentee in not giving notice, or otherwise,) surely it would not be just or right that the purchaser should be deprived of the use of his machine upon the receipt of *subsequent* notice from the patentee that he had a patent on the article. It seems to us that the instruction referred to in the seventh assignment of errors cannot be sustained. But the instruction is objectionable in another respect. It will be seen the jury are told that if the defendants were informed that there was a patent on the *pans*, that was sufficient to put them upon inquiry, and they were bound to pursue it and see what particular part of that machine it covered. "So that if they had actual notice in either of these modes," said the learned judge, "if it was such as to satisfy you that they had notice of the existence of the patent—*a notice of such facts as made it obligatory upon them to ascertain the exact facts—it is sufficient* for this purpose; and if they had this notice, and there was a violation of this patent, the plaintiff is entitled to damages."

Can it be that the patent law will bear the construction here placed upon it, namely, that a person who is in possession of some vague facts, or learns from unauthentic sources that some part of a machine not designated is covered by a patent, is compelled to ascertain the real facts at the peril of being mulcted in damages for infringement if he uses it? Such a construction certainly does not harmonize with the text or spirit of the patent law. That act makes it incumbent on the patentee to give notice of his right in the most definite manner possible, by publishing it on the

thing patented itself, so that no one can be misled or entrapped into buying a thing covered by patent. And furthermore, it requires of the patentee a minute and clear description of whatever he wishes patented, so that all persons, by looking at the specifications, may learn the exact nature of the invention.

We cannot believe that it was ever intended by the framers of such a statute to throw the burden upon the public of making inquiries as to whether any particular thing or machine is patented. A monopoly is given to a person in a certain thing by the United States, and it designates the course to be pursued by him to protect his right. Among other things he is to give notice, and that in a certain way. True, notice that a thing is patented, obtained in a way other than that pointed out, might be sufficient; but can the act be construed as imposing any burden on the public that involves the expense and annoyance which must frequently attend the inquiry as to the truth of a report or rumor that a thing is patented? It will at once suggest itself that it may often be a very difficult matter to accurately ascertain whether a particular machine is in fact patented, and we are certainly not warranted in coming to the conclusion that the public is compelled to rely upon mere rumor or unauthentic report that a machine is patented, or desist from using it, under the penalty of being compelled to pay the royalty. It would seem to be the more rational rule, and the better construction of the act, to throw the entire burden of notice on the person who enjoys the monopoly. If so, then the instruction is erroneous, in that it made it incumbent on the defendants to inquire as to the truth of mere statements that a part of the pan used by them was patented.

VIII.

The instruction quoted in the eighth assignment of error is substantially like the first part of the instruction set out in the seventh assignment, and what is said upon the first

part of that instruction will apply equally to this; therefore nothing further need be said upon it.

IX.

The ninth and last assignment of error involves this proposition: The pans which are the subject of litigation in this case were manufactured for the defendants (plaintiffs in error) by McCone and Greely, who had founderies in the State of Nevada, and each of them, knowing that Wheeler claimed a patent on some kind of improvement on amalgamating pans, took the precaution to inquire of said Wheeler if the kind of pans they were manufacturing was an infringement of his patent. He told them no, and advised them to go on with their work, or at least there was evidence tending to show this state of facts. (See Transcript, page —.)

Subsequently to these assurances from Wheeler, they made and sold the pans in controversy to Birdsall & Co. When on the trial an instruction was asked to the effect that if the jury believed the facts to exist, as above stated, then that Birdsall & Co. were not responsible under such state of facts, the instruction was refused, apparently on the ground that Birdsall & Co. could not claim the protection of the estoppel, because there was no evidence that either McCone or Greely communicated to Birdsall or Langtry the fact of their having had such a conversation with Wheeler. This, we apprehend, was a mistaken view of the law. If such conversation operated as an estoppel in favor of McCone and Greely, or either of them, it was in our opinion equally effective in favor of their vendees.

Of what value would the estoppel be to the manufacturer if he were allowed to make, but not to sell, a patented article; or if he were allowed to make and sell, but the purchaser were not to use; or if he were liable to his vendee for any damages that the patentee might recover against him for such use.

If Wheeler had granted a license to McCone and Greely, or had sold to them for a valuable consideration the right

to manufacture and sell his invention, would it be contended for a moment that their vendees could not use the article after buying it? Does not the right of one party to sell a machine necessarily carry the right to use the machine in favor of the purchaser?

If Wheeler and his assigns were estopped from saying that McCone and Greely did not have a right to make these pans, would he and they not be equally estopped from saying their vendees could not use them?

Again, every vendor of personal property, by the very act of selling, warrants the title. (See Parsons on Contracts, volume 1, pages 573 to 576, and the authorities therein cited.)

The case of Dresser *v.* Ainsworth, 9 Barbour, page 619, goes farther. It holds that—

"The essence of the contract is, that the vendor has a perfect title to the goods sold, that the same are unincumbered, and that the purchaser will acquire by the sale a title free and clear, and shall enjoy the possession without disturbance by means of anything suffered by the vendor."

If this be law, and Birdsall & Co. are mulct in damages, they can certainly recover the same from Greely and McCone.

In such case the estoppel would be gone. We cannot conceive that a party having a good equitable estoppel could be deprived of it in this indirect manner.

Respectfully submitted.

BEATTY & DENSON,
LEWIS & DEAL,
~~*For Plaintiffs in Error.*~~

V. C. J. Filley et
for Pltffs in Error

Supreme Court of the United States.

F. Birdsall and George T. Langtry,
Plaintiffs in Error,

vs.

C. C. Coolidge, Defendant.

Reply by Plaintiffs in Error.

I do not desire, in reply to the brief of counsel for defendant, to add anything to what has been said in our former brief, except upon two points.

First, as to the rule of damages. It appears clearly from the record that the curved plates—covered by the plaintiffs' patent—were only used by defendants for a few weeks and were then thrown aside as useless for their purposes, and this evidence also tends very strongly to show that defendants had no actual knowledge that these plates were patented and that the infringement was accidental and unintentional.

The Circuit Court, however, in its instructions, withdrew from the jury all consideration of these or any other mitigating circumstances, and fixed the royalty or customary license price as the sole criterion of the damage. Its language is, after intimating a doubt as to the correctness of its determination, "if, then, you find any damages, the damages will be the royalty which he obtained from this particular part of his invention; if a royalty of $100 was paid for this invention, then there would be $100 on each frame so used, and interest upon that sum at the rate of interest in this State, ten per

cent. per annum from the date of the appropriation, say from the 1st of October, 1869." (Record, p. 17.)

The rule could in no way be stated with more rigidity and inflexibility. The jury were left no discretion, and, unless it is true that, in all actions at law for an infringement, the license fee, when one exists, is, without regard to the circumstances, the measure of damage, the instruction is erroneous.

The case of The Packet Co. *v.* Sickles, 19 Wallace, 611, is the one mainly relied upon to support this rule. In that case this court undoubtedly did, in general terms, say that the license fee was the proper measure of the damage. But to determine the exact import of this general language, it must be considered in reference to the facts of the case to which it was applied. In that action an excessive verdict had been rendered, under an instruction permitting the jury to estimate the probable profits made by the defendant, and the rule was invoked for the purpose of *limiting* the amount of the recovery by the plaintiff. It may well be that when a patentee has been in the habit of selling licenses at a certain price, he ought not in a case of infringement to recover *more* than this price, because it is improbable that, by an unauthorized use, he should have sustained any greater damage than the amount for which he would have licensed the use. He has himself fixed the limit of his loss, and it is upon this theory that the rule has been framed and applied.

It does not follow, however, that because the patentee may thus conclude himself he can make his price conclusive upon the defendant in an action for infringement. The only ground upon which this could be claimed is the probability that the prices paid by others is a fair remuneration, and that the plaintiff, by the infringement, has lost the license fee which would otherwise have been paid to him for the use. I should very readily admit that, in ordinary cases, this would furnish a fair guide to the measure of damages, and that in a case where the proof showed the existence of a customary license fee and an illegal use by the defendant, and *nothing more*, the presumption that the plaintiff had been damaged

to the extent of the fee would arise and control the amount of damages. But it is easy to see that, in many cases, to make this presumption conclusive, would be productive of injustice, and a direct violation of the statutory provision which limits the amount of the verdict to the *actual damage* sustained by the plaintiff. Suppose a purchaser of a machine, without actual knowledge of the existence of a patent upon the whole or some part of the same, but yet affected with the technical notice prescribed by the law, should use the same for one day, and then, upon ascertaining the existence of the patent, should return or cease to use the same, and suppose this to be done in a case where it could be made clear that another machine, upon which there was no patent, and costing no more, was equally adapted to the purposes for wh[illegible] been used. In an action for infringement these cir[illegible] would certainly not prevent a recovery by the pat[illegible] no one would claim that the lincense fee would, in [illegible], be any fair measure of the actual damage which the plaintiff has sustained. Again, by the payment of the license fee the purchaser obtained the right to the continued use of the patented article so long as it shall last, but by a recovery of damages for an infringement, no right to future use is vested in the defendant. (Suffolk Co. *v.* Hayden, 3 Wallace, p. 315.)

If, by action, the use of an article, capable of lasting for years, should be enjoined after a use of one week, it is evident that the actual damage sustained by the plaintiff by such short infringement is not the amount for which he would have licensed its use indefinitely.

In the case of Packet Co. *v.* Sickles there was nothing which made a consideration of these questions necessary, nor is there anything in the opinion which indicates an intention to exclude mitigating circumstances from having their proper weight in *reducing* the actual damage below the price at which the license is sold.

That such was not the intention appears from the fact that the case of Seymour *v.* McCormick, 16 Howard, (the leading case upon this question of damages,) is not only referred to approvingly and without criticism, but is in fact made the

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That such was not the intention appears from the fact that the case of Seymour *v.* McCormick, 16 Howard, (the leading case upon this question of damages,) is not only referred to approvingly and without criticism, but is in fact made the

basis for the subsequent decision. An examination of the opinions in this leading case will show that while it is our authority for the decision in the latter case, it is not authority for the rule, that as against the defendant the license fee is regardless of circumstances the measure of damage, but, as I read it, directly the contrary. Referring to the acts of 1793 and 1800, the court say, "Experience had shown the very great injustice of a horizontal rule equally affecting all cases without regard to their peculiar merits. The defendant, who acted in ignorance or good faith, claiming under a junior patent, was made liable to the same penalty with the wanton and malicious pirate." * * * * In order to obviate this injustice, the patent act of 1836 confining the jury to the assessment of "actual damages," was passed.

Then directly on the point in question it is further said, "The case of Stimpson's patent for a turn-out in a railroad may be cited as an example. It was the interest of the patentee that all railroads should use his invention, provided they paid him the price of his license. He could not make his profit by selling it as a complete and separate machine. * * * * The only actual damage which the patentee has suffered in such a case is the non-payment of the price which he has put on his license with interest and no more. *There may be cases, as when the thing has been used but for a short time, in which the jury should find less than that sum*, and there may be cases where from some peculiar circumstance the patentee may ~~show~~ *prove* actual damages to a larger amount. *Of this a jury must judge from the evidence, under instructions from the court that they can find only such damages as have actually been proved to have been sustained.* When an inventor finds it profitable to exercise his monopoly by selling licenses to make or use his improvement, he has himself fixed the average of his actual damage when his invention has been used without his license. If he claims anything beyond that amount he is bound to substantiate his claims by clear and distinct evidence; and again, "actual damages must be actually proved, and cannot be assumed as a legal inference from any facts which amount not to actual proof of the fact.

~~That~~ a patentee would have made if the infringer had not interfered with his rights, is a question of fact, not a 'judgment of law.' "

Certainly, not merely the language of the text but the whole spirit of this decision, is in opposition to the proposition that proof of the existence and amount of a customary license fee is *conclusive* of the amount of damage.

In Hogg *v.* Emmerson (11 How., 587) this court had only a short time before, in express terms, laid down the contrary rule. Speaking of the license price, it was there said: "The court, therefore, being called on to lay down some general rule, very properly informed the jury that such price might be a suitable guide, and it is the customary one followed for making and selling patent stoves, lasts, spokes, &c., and seems once to have been treated by law as the chief guide in all patent cases, as the act of 1793 (sec. 5, 1 Stat. at Large, 322) gave three times its amount when one either made for sale or used a patented medicine; but that law being repealed and the damages now left open for each case, the judge correctly added, that a fair ground existed for *a mitigation below that amount, if the maker of the machine appeared in truth to be ignorant of the existence of the patent right and did not intend any infringement.*" And after saying that the absence of intent to injure, although it would not exonerate entirely, might yet mitigate the damages, adds, in conclusion: "That, however, was a matter of discretion for the jury, under all the circumstances, and not a question of law for the court."

The case of Suffolk Co. *v.* Hayden, also referred to approvingly in Packet Co. *v.* Sickles, was an action on the case, like the present, for damages for infringement, but in which there was no proof of any license fee. The court say: "It is proper to say, as was said in the court below, that the jury, in ascertaining the damages upon this evidence, is not to estimate them for the whole term of the patent, but only for the period of the infringement." Is it possible that the right of the defendant to mitigate his damages, by showing that he has only infringed for a short and, compared with the duration of the machine, an unimportant period of time, depend upon

whether the patentee has sold his license sufficiently often to establish a customary license fee? In the present case, as said before, the payment of the license fee gave the right to use the patented improvement for the whole period (ordinarily many years) during which the pans upon which the fees were paid should last. Under the ruling of the court below, the fact that the use had been only for a few weeks could not be considered by the jury, but the damage was to be the price fixed by plaintiff as the value of the use for the whole period. Yet had the plaintiff failed to establish a license fee, the same judge would have told the jury that the damages must only be the value of the use during the "period of the infringement." In a like case, where the existence of a license fee was in doubt, the court would say to the jury, if the evidence has, in your opinion, established a license fee for the use of the plaintiff's improvement during the existence of a pan, you will find damages to the amount of this fee, without reference to the length of time during which the improvement has been used; but if not, you will, in determining the value of the use, make proper allowance for the greater or less length of the period of infringement. I think a judge would hesitate before the evident inconsistency or principle of the alternative of such an intention.

In the case of Philp *v.* Nock, (17 Wallace, p. 460,) decided the same year and very shortly previous to the case of Packet Company *v.* Sickles, this court treating the same question and with a like view to limit damages exceeding the license fee, uses this language: "The measure of the damages to be recovered against infringers prescribed by the act of 1836, as well as by the act of 1870, is the actual damages sustained by the plaintiff. When the plaintiff has sought his profit in the form of a royalty paid by his licensees, *and there are no peculiar circumstances in the case*, the amount to be recovered will be regulated by that standard.

In thus recognizing the license price as a general standard, and in yet permitting its influenec to be modified by proof of peculiar circumstances, this decision is in strict harmony with

all those which had preceded it, including that of Seymour *v.* McCormick, expressly affirmed in Packet Company *v.* Sickles.

In the case at bar there were many peculiar circumstances which should have been submitted to the jury under the rule, as above stated, in mitigation of damages. In September, 1869, the defendants purchased from regular dealers twenty pans containing the curved plates or wings, the use of which is claimed as an infringement.

These wings were never used at all in four of the pans. In the other sixteen they were used not exceeding six weeks, and were then taken out as useless, and were never used afterwards. (See Record, p. 12.)

There was direct testimony that the defendants acted innocently and in ignorance of the existence of the patent on these wings. (Record, p. 15.) The defendant sought during the trial to introduce evidence showing that these wings were not considered by the defendants of sufficient value to have been used by them had they known there was a patent upon them, and this evidence was ruled out by the court in conformity with the view of the law subsequently embodied in its instruction on the subject of damage. (Record, p. 15.) The record shows that the license fee of $100 authorized the licensee to renew the wings so long as the pan in which they were to be used should last, (the wings being so constructed and attached as to be renewed when worn,) and that a pan will last many years, those purchased in 1863 being still in use in 1869. The fact that defendants ceased using these wings in any of their pans in October, 1869, and that suit was not commenced until April, 1873, shows that the plaintiff did not commence the action under any supposed necessity of vindicating his patent or of promoting its uses in the future, but for no other purpose than the recovery of a money judgment. I think it will be considered that there were circumstances tending strongly to show that but very little, if any, actual damage had been sustained by the plaintiff, and under the rule of this court, as I have above supposed it to be, the jury should have been permitted to pass upon this question.

Second—The instruction of the learned judge of the circuit, respect-

ing the effect of a verbal notice to defendants after their purchase of the pans, (see 7th Assignment of Error,) cannot, it seems to me, be sustained. The facts which it assumes and to which it is applicable are these: In 1863, defendants had purchased from Booth & Co., in Sacramento, twenty pans, upon which Booth & Co. paid a license fee to Wheeler. These pans were not in any manner marked patented as required by the act then in force, at least so defendants testified, and the testimony appears not to have been contradicted. (See Record, p. 14.) In 1869 defendants purchased of Greeley & Co. and McCone & Co., manufacturers in Virginia City, twenty other pans precisely like those purchased in 1863, and not marked patented.

There was no testimony that any pans made by Wheeler & Co. were marked patented, or that either Greeley & Co. or McCone & Co. had seen any so stamped. The instruction in question assumes that no notice, as required by the act, was ever given to Greeley & Co. or McCone & Co. prior to the sale of these pans by them to defendants. After the sale, however, and while the pans were being put up, but before their use, as plaintiffs claimed to have proved, notice was given to the defendants. The substance of the instruction is that if such were the facts this notice was good under the section of the patent act, (see former brief, p. 20,) in reference to which it was given; that is, the court held that although the manufacturers would, under the statute, have been protected against an action for infringement in making and vending the improved pan, yet the purchasers could by notice subsequent to the sale be made liable for its illegal use. The theory of the defense on this point was that the patentee had sold and authorized to be sold a large number of these pans with his improvement without "affixing thereon in any manner the word patented and date of patent," or in any way giving "notice to the public that the article was patented as required by the act then in force;" that as a consequence of this McCone & Co. and Greeley & Co., being thereby misled, were not at the time when the sale was made by defendants liable to any action for making and vending these improved

pans without a license. Although these facts were some of them contested by the plaintiff, yet in this instruction the court directs the jury that, if they were all true, yet the subsequent notice to defendants made them liable for the use. I think this is at variance with the well-settled doctrine of this court respecting the difference between the liability of a manufacturer or vendor and a purchaser of a patented article for his own private use. In Chaffee *v.* The Boston Belting Co. (22 How., 217) the question was whether one who had purchased a patented machine was entitled to use the same during the term of an extension of the patent, and the court say:

"When the patented machine *rightfully passes* to the hands of the purchaser from the patentee, or from any other person by him authorized to convey it, the machine is no longer within the limits of the monopoly. * * * By a *valid sale and purchase* the patented machine becomes the private, individual property of the purchaser, and is no longer protected by the laws of the United States, but by the laws of the State in which it is situated. Hence, it is obvious that if a person *legally acquires* a title to that which is the subject of letters patent, he may continue to use it until it is worn out, or he may reform it or improve upon it as he pleases, in the same manner as if dealing with property of any other kind."

In Bloomer *v.* Millinger (1 Wall., 340) the court points out the distinction between the "purchaser of the exclusive privilege of making or vending" and the "purchaser of the implement or machine for the purpose of using it in the ordinary pursuits of life," and in reference to the latter quote and indorse what had been before said in Chaffin *v.* Benton Belting Company.

Under these decisions, the test of the correctness of the instructions of the court below is limited to the single inquiry whether the sale of these improved pans by the manufacturers to the defendants was a valid sale. If by the purchase the defendants "legally acquired a title" to these improved pans, they were no longer "within the monopoly," and no subsequent notice could be of any avail. Unless the section of the act of Congress is meaningless, the manufacturers in

Supreme Court of the United States.

F. BIRDSALL AND G. T. LANGTRY,
Plaintiffs in Error,

vs.

C. C. COOLIDGE,
Defendant in Error.

BRIEF FOR DEFENDANT IN ERROR.

A. H. EVANS & CO.,
for Defendant in Error.

WASHINGTON, D. C.:
GIBSON BROTHERS, PRINTERS.
1876.

United States Supreme Court.

F. BIRDSALL and G. T. LANGTRY, Plaintiffs in Error,

vs.

C. C. COOLIDGE, Defendant in Error.

BRIEF OF A. H. EVANS FOR DEFENDANT IN ERROR.

This suit was brought in the circuit court of the United States for the district of Nevada, by C. C. Coolidge, legatee of Zenas Wheeler, deceased, to recover from the plaintiffs in error damages for having used certain improvements in amalgamating pans, claimed by the defendant in error to have been invented by, and patented to Wheeler by letters-patent issued to him on the 8th day of November, A. D. 1863. The claim charged to have been infringed reads as follows:

"3. In combination with the muller D and pan *a*, the curved plates L, supported at their ~~outer~~ ends in slides N, and at their inner ends in frame M, which is supported on the upper end of the shaft G in such a manner that the plates L will follow any adjustment of the muller, and thus bear same relation to it, whether in its highest or lowest working position, as specified."

I.

It is admitted that the plaintiffs in error used the combination as set out in the claim; but it is denied that the

particular muller used had all the adjuncts described in the body of Wheeler's specification.

It is also admitted that the plaintiffs in error had previously purchased twenty of Wheeler's patented pans, on which they paid the patentee $2,000 royalty, or $100 on each pan; hence there can be no disputing the fact that the plaintiffs in error had not only full knowledge of Wheeler's patent, but also knew the royalty charged on them, and the true value of the patented article. The value seems to have been sufficiently great to induce the parties to attempt to double the number of pans by an act of piracy.

II.

In view of these admitted facts the assignment of errors will be considered.

First. It is charged that the court below erred in refusing the following instructions:

"The Wheeler patent here introduced in evidence, so far as this case is concerned, is for a combination of the curved plates and the pan and muller *described in the specifications* and patent. As there is no evidence that wings or curved plates were ever used in connection with the pan and muller *described*, you must find for the defendant."

It requires but a slight acquaintance with patent law to enable any one to know the court was entirely correct in refusing the instruction asked. The claim which the plaintiffs in error had infringed was a broad claim for the combination of the *curved plates* with a pan and muller, regardless of the particular construction of the latter or of their various adjuncts. If the three elements named in the claim were used by the plaintiffs in error, and these elements operated in the same way to produce the same result, the infringement was complete, regardless of the

particular description which may have been given of Wheeler's pan in his specification. The proposition of the infringers to dodge responsibility by omitting the "spiral ribs" described in Wheeler's specification, and covered by his first claim, is absurd, and originates in a profound misconception of the patent law.

Second. The following question was asked one of the plaintiffs in error:

"With regard to these wings that were sent there with the Greely and McCone pans, did you consider them of sufficient value to have retained them if you had been told there was a claim of patent-right upon them?"

This question was ruled out by the court below, and this ruling is assigned as the second error. The impropriety of the question is too manifest to need argument. The theory of the objection is unfounded in fact, and upon that ground should be overruled.

Hecker *vs.* Fowler, 2 Wallace, 123.

What possible difference could it make, so far as the fact of infringement was concerned, what the witness may have considered the value of the wings to be? He *knew* the wings were patented, and that his firm had paid $2,000 royalty on their first purchase. The law supposes a person to act intelligently in his business transactions, and the legal presumption is that the plaintiffs in error knew precisely what Wheeler's patent covered when they purchased his pans and paid the royalty. That the pans were valuable is proven conclusively by the fact that the purchasers several years subsequently duplicated their order.

Counsel for the plaintiffs in error urge this second assignment only on the ground that their clients are "free from all suspicion of wilful or intentional wrong." This

they do in the face of the admitted facts and the testimony of Coolidge, who swears that he cautioned Birdsall & Co. against the infringement.

Counsel also argue that the curved plates or wings were of no benefit to their clients. The statement of admitted facts says:

"At first, the mill (of the plaintiffs in error) was used as a quartz mill, in which it was necessary to *grind*. So long as the mill was so used *said wings were used;* but when they ceased to use it as a quartz mill, and worked *tailings*, they took out the wings. *Then* was the time they became useless."

Thus it is shown, by the statement of facts, that the value of the wings was never doubted when the mill was in its proper use as a quartz mill. The patented invention of Wheeler was specially designed for a quartz mill, and for such use it was purchased by the plaintiffs in error. The fact that they subsequently worked only tailings, and during this operation laid aside the wings, cannot affect the rights of the patentee in his claim for damages. As reasonable would it be to claim a return of a portion, or all of the $2,000 paid Wheeler as royalty on the first purchase of his pans. It is confidently submitted that the court below acted with great legal propriety in ruling out the question propounded.

Third. It is not deemed necessary to offer any argument on the third assignment of error. The court was clearly right in that portion of the charge in which the learned judge says:

"And the very fact that they (the public) do purchase and use a patented instrument is a circumstance which they (the jury) are entitled to consider in reference to the other testimony on the subject to show that it was useful."

This part of the charge was excepted to, and forms the third assignment of error.

Fourth. The rule of damages laid down by the court, and which forms the basis of the fourth assignment of error, is a well-recognized rule, as shown by numerous authorities.

Suffolk Company *vs.* Hayden, 3 Wall., 315.

"In the case of Seymour *vs.* McCormick, (16 How., 480,) this court, on full consideration and without dissent, laid down the proposition that in suits at law for infringement of patents, where the sale of license by the patentee had been sufficient to establish a price for such licenses, that price should be taken as the measure of his damages against the infringer. The rule thus declared has remained the established criterion of damages in cases to which it was applicable ever since."

Packet Co. *vs.* Sickles, 10 Wall., 611.
Sickles *vs.* Borden, 4 Blatchford, 14.
Livingston *vs.* Jones, 3 Wall., 330.

The court, after laying down the rule of damages which should govern the case, directed that the jury might add to the amount of damages found, interest upon the same at the rate of 10 per cent. This the jury did, and returned a verdict for the gross amount. The court accepted the verdict, and refused to add punitive damages as authorized by the statute. As it was a clear case of wilful piracy, the plaintiffs in error should have been more than satisfied with the leniency of the court, the prayer for treble damages being refused.

Fifth. The court intructed the jury that "they might find for the plaintiffs, although they did not find any damages for him." This was excepted to, and forms the fifth assignment of errors, although the counsel, in their brief, properly say:

"The fifth exception cuts no figure in the case as it now stands;" and we pass on to the

Sixth. It is equally difficult to imagine the figure which this exception was designed to cut, as the statute (sec. 4900) provides for notice to infringers other than by marking the word "patented" on the article to be protected. In this portion of the charge the court simply paraphrased the wording of the law. Nor is it required by the statute that each and every element in a combination shall be marked "patented."

Seventh and eighth. These assignments of error cover the same ground, and it is confidently submitted that "if Wheeler sold his patented machine to Birdsall & Co. in 1863, without any mark on it to indicate it was patented," (*and Birdsall & Co. paid Wheeler a royalty of* $2,000.00 *on it as a patented article,*) "Wheeler could recover against Birdsall & Co. for using others of the same kind, purchased from other manufacturers" (to avoid the royalty) in 1869, and where the purchasers *knew the royalty had not been paid.* This proposition seems too clear for argument, and yet on its negation, counsel for the plaintiffs in error rest their whole case.

Birdsall & Co. had promptly paid royalty on the pans purchased in 1863, and they are estopped from pleading a want of notice. As before stated, they are presumed to know why and for what they paid the royalty. They *knew* Wheeler held the patent on the pan, and they paid him two thousand dollars, and now the effort is made to show these parties to have been *innocent* infringers.

The construction given to the statute by the counsel for the plaintiffs in error will scarcely meet the approval of the court. They would hold responsible only those who continue *to make* and *vend*, and not those who would continue *to use* the article patented. It might be claimed that

the *manufacturers* of these pans were ignorant of Wheeler's rights, but surely Birdsall & Co. were not. The statute was never intended to hold to strict accountability the ignorant, while the wilful pirate of the inventor's rights should go scot free. Birdsall & Co. had paid $2,000 for a knowledge of Wheeler's rights, and must have been impressed, to that extent at least, with the value of his invention. They are certainly estopped from pleading ignorance. Their purchase from Greely & McCone was a guilty purchase, conceived in fraud, and executed in wilful violation of the rights of the patentee.

Ninth. Greely and McCone testify that "Wheeler saw at their respective shops other pans of their manufacture made like those *sold* defendants, except that said pans seen by him *did not at the time seen actually have in them the curved wings or plates.*"

Without these wings or plates there was no infringement. "Each asked Wheeler if his said pans in any way infringed (Wheeler's) said patent, and that Wheeler in each case replied that the said pans did not in any way infringe on his patent."

Wheeler could not have answered otherwise, for the essential element in Wheeler's combination was not in the pans shown him. It will also be particularly noticed that this conversation is reported to have taken place *after* the purchase by Birdsall & Co. of the twenty pans forming the subject of this suit. The witnesses say, plainly, that the conversation with Wheeler was in relation to "other pans of their manufacture like those *sold* to defendants." From this language we conclude that, *after* the sale to Birdsall & Co. of twenty pans, they manufactured "other pans like those sold," and the conversation with Wheeler referred to these other pans, and which, as yet, had in them no curved wings or plates.

It is plain that the counsel for plaintiffs in error, in their ninth and last assignment, have misapprehended the testimony regarding this conversation, as well as the time at which it took place.

But suppose, for the sake of argument, that the conversation was prior to the purchase by Birdsall & Co., what would be the legal effect upon the rights of Wheeler?

III.

The doctrine of estoppel fails in its application here. The character of estoppel urged against the defendants in error is a branch of equitable estoppel, or estoppel *in pais*, known as estoppel by conduct. It is stated in Bigelow on Estoppel, (p. 600), to establish estoppel of the kind in question, it must be shown—

1. That the party sought to be estopped has made an admission, or done an act, *with an intention* of influencing the conduct of that another; or he had reason to believe, as a man of ordinary prudence, would influence his conduct inconsistent with the evidence he proposed to give, or the title he proposed to set up.

2. That the other party has acted upon or *been influenced* by such act or declaration.

In the present case, there is no testimony tending to prove that Birdsall & Co. ever heard of the declarations of Wheeler, or to show they had been influenced by those declarations, or that Wheeler made the alleged declaration with an intention of influencing them. Estoppel only applies where the parties are privy to the conduct set up.

Kinsman *et al. vs.* Parkhurst, 18 How., 289.

Eureka Co. *vs.* Bailey, 11 Wall., 488.

Sprigg *vs.* Bank of Mt. Pleasant, 10 Pet., 257.

"As a general rule, a party will be concluded from

denying his own acts or admissions, *which were expressly designed to influence* the conduct of another, *and did so influence it*, and when such denial will operate to the injury of the *latter*."

Welland Canal Co. *vs.* Hathaway, 8 Wend., 480.

There is no evidence tending to prove that Wheeler made any admissions or did any acts which were *designed* to influence the conduct of the plaintiffs in error, or that it did influence them; nor did he make any admissions, according to the evidence, which the defendant in error would wish to deny. The pans which Wheeler saw in the shops of Greely and McCone "did not, at the time seen, actually have in them the said curved wings or plates," and Wheeler said to Greely and McCone "that the said pans did not in any way infringe upon his patent." The defendant in error would not deny this declaration on the part of Wheeler. It was the truth. The pans without the curved wings or plates did not infringe the patent. The plaintiffs in error are welcome to the admission.

But when the court was asked to charge the jury upon a theory unfounded in fact, the request would have been properly overruled on this ground alone, as stated by Mr. Justice Clifford in the case of Hecker *vs.* Fowler before cited. The court, however, refused, and properly refused the instructions, "on the ground, among others, that there was no testimony tending to show that the declarations of Wheeler referred to in the instructions asked were brought to the notice of the plaintiffs in error, and that this essential element of estoppel was wanting."

Respectfully submitted.

A. H. EVANS,
For Defendant in Error.